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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|--|
| Proceeding             | 91175319   |
| Party                  | Plaintiff<br>Intuitive Surgical, Inc.  |
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| Attachments            | DVDIDIntuitive Reply Trial Brief.pdf ( 29 pages )(727760 bytes )<br>DVDIDIntuitive Appendix2.pdf ( 23 pages )(444131 bytes )<br>DVDIDIntuitive Response to Evidentiary Objections.pdf ( 10 pages )(242171 bytes )<br>DVDIDIntuitive POS.pdf ( 1 page )(18868 bytes ) |

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|-------------------------------|---|------------------------------|
| INTUITIVE SURGICAL, INC.,     | ) |                              |
|                               | ) |                              |
| Opposer,                      | ) | Opposition No. 91175319      |
|                               | ) |                              |
| v.                            | ) | Serial No. 78/728,786        |
|                               | ) |                              |
| DAVINCI RADIOLOGY ASSOCIATES, | ) | Published: December 19, 2006 |
| P.L.,                         | ) |                              |
|                               | ) |                              |
| Applicant.                    | ) |                              |
|                               | ) |                              |

OPPOSER INTUITIVE SURGICAL, INC.'S REPLY TRIAL BRIEF

Opposer Intuitive Surgical, Inc. ("Opposer") hereby presents its reply trial brief in this Opposition Proceeding and requests the Trademark Trial and Appeal Board (the "Board") sustain Opposer's opposition for the reasons set forth below.

**I. EVIDENTIARY OBJECTIONS**

Applicant has made evidentiary objections in its brief to the testimonial deposition of Benjamin Gong and Exhibit 27 (referred to as IS-27 herein) thereto and to Exhibits 2 through 7 to Opposer Intuitive Surgical, Inc.'s First Notice of Reliance (referred to herein as ISNR1-2 through ISNR1-7)<sup>1</sup>. Opposer's responds to these evidentiary objections in Opposer Intuitive Surgical, Inc.'s Response to Applicant's Evidentiary Objections, submitted herewith pursuant to 37 Code of Federal Regulations § 2.128(b), Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 801.03 and *Harjo v. Pro-Football Inc.*, 45 U.S.P.Q.2d 1789, 1792 (TTAB 1998).

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<sup>1</sup> Opposer uses herein the same abbreviations to refer to testimony and exhibits as used in Opposer's Brief.

## II. ARGUMENT

In an attempt to obfuscate the issues and evidence in this Proceeding, Applicant DaVinci Radiology Associates, P.L.'s ("Applicant") has responded to Opposer's Main Trial Brief ("Opposer's Brief") by presenting numerous mischaracterizations – or misunderstandings – of applicable law and cherry-picking the evidence of record to suit its tortured legal analysis. A determination of likelihood of confusion should be based on an application of the law to all probative and admissible evidence of record. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992). Opposer requests that this Board see through Applicant's distortions and base its opinion on the entire record before it. Applicant's mark DAVINCI DIAGNOSTIC IMAGING & Design ("Applicant's Mark") is confusingly similar to Opposer's marks DA VINCI, DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) (singly "Opposer's Mark" and collectively "Opposer's Marks"), among others, and should be denied registration on the Principal Register.

### A. The Parties' Marks are Confusingly Similar

As a preliminary matter, Applicant incorrectly asserts that only Opposer's mark DA VINCI may be the basis for its opposition to the registration of Applicant's Mark. Applicant's Brief at p. 4. Opposer has rights and priority in each of the marks DA VINCI,<sup>2</sup> DA VINCI S,<sup>3</sup> DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized). Opposer's Brief at pp. 7-8. An opposition proceeding may be based on a registered

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<sup>2</sup> Applicant erroneously asserts Opposer has not established use of its DA VINCI mark prior to July 7, 2000. Applicant's Brief at p. 7. Even if Opposer's first use of DA VINCI was on July 7, 2000, Opposer's first use nonetheless predates Applicant's first use of its mark.

<sup>3</sup> Since Opposer filed its First Notice of Reliance with which it submitted the application file for DA VINCI S, Opposer's mark DA VINCI S has registered. DR-2 at item 28 (U.S. Trademark Registration No. 3,561,484).

mark and/or a party's common law trademark rights. 15 U.S.C. § 1052(d); *Fossil, Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451 (TTAB 1998). Opposer has properly relied on each of these marks for purposes of this Proceeding.

In determining the similarities of trademarks, the marks must be compared in their entireties. *MarCon, Ltd. v. Avon Products, Inc.*, 4 U.S.P.Q.2d 1474, 1476 (TTAB 1987). However, "it is well-settled that one feature may be more significant than another and it is not improper to give more weight to the dominant feature in determining the commercial impression created by [a] mark." *In re Rocktron Corp.*, 1999 WL 769940, Serial No. 74/531,669 at \*1 (TTAB Aug. 31, 1999) (citing *In re National Data Corp.*, 224 U.S.P.Q. 749 (Fed. Cir. 1985)).<sup>4</sup> See also *In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d 1944, 1946 (Fed. Cir. 2004). Similarities of marks are weighed more heavily than differences. *GoTo.com, Inc. v. Walt Disney Co.*, 53 U.S.P.Q.2d 1652, 1656 (9th Cir. 2000).

Applicant claims its Mark differs from Opposer's mark DA VINCI because the parties' respective marks are pronounced differently, differ in appearance, have distinct connotations, and differ in overall commercial impression. Applicant's Brief at pp. 13-17. Applicant's assertions are erroneously based on comparisons of the marks in their entireties with no regard for the commercial strength or weakness of their component terms or for the absolute identity of their dominant – and in the case of Opposer's DA VINCI mark, only – term DA VINCI.

**1. The Parties' Marks are Similar in Sound and Appearance.**

Both parties acknowledge that, in their entireties, their respective marks are pronounced differently. See Opposer's Brief at p. 33; Applicant's Brief at p. 13. However, Applicant's

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<sup>4</sup> *In re Rocktron Corp.* is a Board decision designated not citable as precedent. By way of the Board's January 23, 2007 *Official Gazette* Notice, Board decisions designated as non-precedential are not binding on the Board but may be cited in Board proceedings for their persuasive value. Copies of all opinions not designated as precedent and cited herein, as well as the January 23, 2007 *Official Gazette* Notice, are included in the Appendix of Authorities submitted herewith.

Internet website and the brochures distributed by Applicant's licensee both refer to Applicant's licensee and its services as "daVinci". IS-12 at "index" & "difference"; IS-5, IS-6, IS-7, IS-10. Such use encourages consumers to similarly refer to the services offered under Applicant's Mark as "daVinci" – the entirety of one of Opposer's Marks. *See In re Appetito Provisions Co.*, 3 U.S.P.Q.2d 1553, 1554 (TTAB 1987).

Viewed in its entirety, Applicant's Mark includes the terms DIAGNOSTIC and IMAGING and a design element as well as the dominant term DAVINCI.<sup>5</sup> Opposer's Brief at pp. 29-31. The terms DIAGNOSTIC<sup>6</sup> and IMAGING are descriptive of the services offered by Applicant's licensee. Applicant's Brief at pp. 14-15. Although even descriptive and disclaimed terms are considered part of the mark as a whole to determine similarity of the marks, they are not capable as serving as source identifiers and are given less weight in the similarity analysis. *See In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d 1944, 1946 (Fed. Cir. 2004) (a disclaimed term was properly accorded less weight in assessing similarity of the marks). The design element in Applicant's Mark consists, in part, of Leonardo da Vinci's famous Vitruvian man sketch superimposed on the "D" of the DAVINCI term. This design element merely "reinforces the Renaissance and DaVinci connotations of the text." Applicant's Brief at p. 16. Accordingly, DIAGNOSTIC and IMAGING terms as well as the design element are discounted for purposes of determining the connotation of the Applicant's Mark. *In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d at 1946; *In re Rocktron Corp.*, 1999 WL 769940 at \*2 (the design element of a mark consisting

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<sup>5</sup> Applicant's refers to the presence or absence of a space in and capitalization or lower case presentation of the "D" in DA VINCI as differences in the appearances of the parties' respective marks. However, these spacing and capitalization differences do not distinguish the marks from one another. Moreover, Opposer's DA VINCI mark is registered in block form. *See* ISNR1-1. Opposer is therefore free to change the display of its DA VINCI mark at any time. *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 U.S.P.Q.2d 1744, 1747 (TTAB 1987).

<sup>6</sup> Applicant requests the Board take judicial notice of the dictionary definition of the term "diagnostic", even though Applicant failed to submit the definition as evidence in this Proceeding. Applicant's Brief at n. 2. Opposer does not object to its admission into evidence.

of the letters "CS" inside a circular, block shaped arrow was not the dominant part of the mark because it suggested the surround-sound technology covered by the application at issue).

**2. The Parties' Marks Have Similar Connotations and Commercial Impressions.**

Applicant asserts the parties' marks differ in meaning because Applicant's Mark connotes "medical diagnostic imaging services reborn and on a level of genius" and that Opposer's DA VINCI mark connotes Leonardo da Vinci and the Renaissance. Applicant's Brief at p. 16. When the component terms of the parties' marks are given their appropriate weight, however, the connotations and overall commercial impressions of the parties' respective marks are similar.

DA VINCI is the only term and the dominant term in Opposer's Marks and the dominant term in Applicant's Mark. Opposer's Brief at pp. 29-31. "Da Vinci" is the commonly known surname of the famous 16th Century artist, scientist, innovator and Renaissance man Leonardo Da Vinci who is known for, among other things, his scientific observations and theories and for his wide array of interests and talents. The name "Da Vinci" connotes the classic Renaissance man and embodies artistry, scientific innovation, precision, intelligence, sophistication and versatility, particularly when used, as here, in association with goods or services in the medical field where patients and physicians seek the most advanced and sophisticated technologies available. Opposer adopted its DA VINCI marks in light of the accomplishments of the ultimate Renaissance man Leonardo Da Vinci. The evidence of record demonstrates that Applicant chose the term "DaVinci" in part to connote "a high level of sophistication and intelligence" and because it has "[R]enaissance implications[.]" Opposer's Brief at pp. 6 & 31-32.

In *In re Chatam Int'l Inc.*, the Board compared the marks JOSE GASPAR GOLD for tequila and GASPAR'S ALE for beer. 71 U.S.P.Q.2d at 1946. The Board discounted the constituent terms ALE, JOSE and GOLD as significant differences between the two marks

because: ALE is generic for beer, was disclaimed and had only nominal commercial significance; JOSE simply reinforced that GASPAR is a person's name and did not alter the commercial impression of the mark; and GOLD is descriptive for tequila and did little to alter the commercial impression of the mark. *Id.* The Board discounted the commercial significance of the ALE, JOSE and GOLD terms and held both marks convey the commercial impression that a single name, GASPAR, is the common source of the parties' respective goods. *Id.*

As in *In re Chatam Int'l Inc.*, the parties' respective marks here convey similar commercial impressions. As described in Section 2.A.1 above, the DIAGNOSTIC and IMAGING terms in Applicant's Mark are descriptive and have little commercial significance. Further, the design element in Applicant's Mark only serves to reinforce the connotation of its DAVINCI term. *Id.* Given the lack of commercial significance of the DIAGNOSTIC and IMAGING terms and the reinforcement of DAVINCI by the design element, these elements are given less weight than the DAVINCI term in determining the Mark's overall commercial impression. *See In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d at 1946.

Inexplicably, Applicant asserts that the overall commercial impression of its Mark is that of a "renewal" of medical diagnostic imaging "on a level of genius" and that "Opposer's Mark has no commercial impression." Applicant's Brief at p. 17 (emphasis added). Any designation capable of functioning as a trademark, by definition, has a commercial impression. Opposer's mark DA VINCI is a registered mark, has been functioning as a trademark for many years and certainly has a commercial impression. *See* Opposer's Brief at pp. 6-7. Both marks provide an overall commercial impression of sophistication and technological advancement (here, in the medical field). Both marks immediately convey the image of Leonardo da Vinci, the Renaissance and all they imply with regard to medical and scientific advancement, particularly since DA VINCI is the only term in Opposer's DA VINCI mark and is given the greatest weight

in Applicant's Mark. The overall commercial impressions of the parties' respective marks are confusingly similar.

**B. The Goods and Services Offered Under the Parties' Respective Marks are Related.**

Despite Applicant's averments to the contrary, the parties goods and services offered under their respective marks are related. Applicant erroneously argues that, because the image/video display feature (referred to by Applicant as "picture-in-picture") is not expressly included description of goods covered by Opposer's registration of DA VINCI and Opposer's goods offered under DA VINCI do not include that feature, the parties' respective goods and services are unrelated.<sup>7</sup> Applicant's Brief at pp. 18-19. Applicant's assertions simply are incorrect. In fact: (1) the parties' respective goods and services both occupy the medical field and are encountered by the same users in an environment that would give rise to a likelihood of confusion; (2) Opposer has rights in all goods identified, even broadly, in its registrations; and (3) Opposer's registration of DA VINCI expressly includes the imaging/video display feature.

First, Applicant admits, the parties' respective goods and services need not be identical or even competitive to support a finding of likelihood of confusion. *Barbara's Bakery Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1286 (TTAB 2007); Applicant's Brief at p. 19. Instead, a likelihood of confusion is supported where the goods and services are related in some manner or the circumstances surrounding their use or conditions and activities surrounding their marketing are such that they would or could be encountered by the same persons under circumstances that could give rise to a mistaken belief that they originate from or are associated with the same source. *In re Jump Designs LLC*, 80 U.S.P.Q.2d 1370, 1374 (TTAB 2006); *Barbara's Bakery*

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<sup>7</sup> Applicant also asserts that surgeon confusion is not "purchaser" confusion relevant here and, in any event, surgeons are aware Opposer does not practice medicine and the parties' goods and services are not related. Applicant's Brief at pp. 21-22. These arguments are addressed in Sections II.C.1 & II.D.n.12 below.



*Inc.*, 82 U.S.P.Q.2d at 1286. In this case, the parties' goods and services offered under their respective marks are related and are encountered by the same persons under circumstances in which there is a likelihood of mistaken association between the parties.

Opposer's goods are surgical systems and their associated instruments (the "Surgical Systems" or "Systems"). *See, i.e.*, ISNR1-1. Applicant's services are medical diagnostic imaging services, including the production of MRI and CT images analysis of those images, and production of resultant reports. Boyle Tr. at 16:9-17:1, 34: 6-21; ISNR1-9 at Admission No. 4. The parties' respective goods and services both are in the medical field, are computerized, involve highly advanced optic and imaging technology and are used by health care professionals. Opposer's Brief at pp. 9-12 & 21-22. Moreover, both are encountered by surgeons and patients in situations that would give rise to a likelihood of confusion as to source. Diagnostic imaging services of Applicant's licensee are ordered by both surgeon and non-surgeon physicians and directly by patients. The images and reports produced by Applicant's licensee are used by surgeons to diagnose and treat patients. *Id.* at pp. 24-25. Surgeons also use Opposer's goods to perform surgery on patients. *Id.* at p. 9. Since the services from Applicant's licensee can be ordered by patients directly and by physicians other than surgeons, surgeons who ultimately perform a "da Vinci" surgery can view diagnostic images and resultant reports generated by Applicant's licensee without having themselves ordered the images and without any familiarity with Applicant's licensee or its lack of relationship with Opposer. *See Synthes (U.S.A.) v. Cypress Medical Products, L.P.*, Opposition No. 91123720 & Cancellation No. 92031730, 2004 WL 1957205 at \* 8 (TTAB 2004) (opposer's instruments used in bone surgery and applicant's disposable gloves for medical use are related because they are encountered and used by the same surgeon and operating staff end users in the same environment). Moreover, an even greater likelihood of confusion exists among patients who do not have specialized knowledge regarding

the parties' goods and services. Patients may order diagnostic imaging services directly from Applicant's licensee and, in some case, are themselves provided with the resultant images and reports. Opposer's Brief at pp. 24-25. Much of Opposer's marketing of goods under its Marks is directed specifically toward patients. *Id.* at pp. 15-18. Patients facing surgery, and obtaining imaging services in preparation for that surgery, will encounter both parties' respective marks in connection with the medical and surgical process. Even disregarding the feature of Opposer's goods that allows for diagnostic imaging to be displayed in the Surgical System during surgical procedures, both surgeons and patients encounter the parties' respective goods and services under their marks in situations that give rise to a likelihood of confusion.<sup>8</sup>

Second, Applicant asserts that the simultaneous encounter by surgeons of Opposer's goods and the images and reports produced by Applicant's licensee (as displayed in Opposer's goods) should be disregarded because the image/video display function of Opposer's goods is not expressly described in its registration of DA VINCI.<sup>9</sup> Applicant's Brief at p. 20. The image/video display function of Opposer's goods need not be set forth in Opposer's registration to be relevant evidence probative of the similarity of the parties' goods and services.

It is well-settled that likelihood of confusion is to be determined based on the goods and services identified in the application and registration at issue. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, U.S.P.Q.2d 1813, 1814 (Fed. Cir. 1987). Specifically, the goods or services identified in a prior registration should not be narrowed to avoid a finding of similarity. *See id.* at 1814 & 1816; *In re Trackmobile Inc.*, 15 U.S.P.Q.2d 1152, 1153 (TTAB 1990). Although a registrant may not be using its mark for all possible goods identified in a

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<sup>8</sup> This mistaken perception is particularly likely since the parties' respective goods and services are used in conjunction with one another and conceivably could be seen as complimentary. *See In re Decombe*, 9 U.S.P.Q.2d 1812, 1814-15 (TTAB 1988) ("complementary use is clearly another factor to be considered in the likelihood of confusion analysis"); *In re Hester Industries, Inc.*, 231 U.S.P.Q. 881, 882 (TTAB 1986) (frozen precooked chicken and bread are often eaten together and are, therefore, complimentary goods).

broad goods description set forth in its application, its business practices may change and all the registrant's rights in the mark must be considered by the Board. *Canadian Imperial Bank of Commerce*, 1 U.S.P.Q.2d at 1814-15 (improper to limit the range of "banking services" covered by a registration to avoid a determination that an applicant's services are similar); *In re Bercut-Vandervoot & Co.*, 229 U.S.P.Q. 763, 764 (TTAB 1986) ( by arguing both parties' wines are expensive and sold to a small group of sophisticated consumers, applicant impermissibly sought to restrict the scope of goods covered by the parties' respective application and registration); *In re Rocktron Corp.*, 1999 WL 769940 at \*1 (extrinsic evidence that registrant used its mark only with guitar amplifiers was not considered because it would have narrowed registrant's rights in the mark for use with "amplifiers"). In fact, extrinsic evidence is relevant and considered by the Board to provide information about and clarify the nature of goods when the description of goods in a registration is unclear. *In re Trackmobile, Inc.*, 15 U.S.P.Q.2d at 1153 (when a description of goods is somewhat unclear, it is improper to simply consider that description in a vacuum when evidence has been presented showing the description of goods has a specific meaning to members of the trade). See also *In re Hyper Shoppes (Ohio) Inc.*, 6 U.S.P.Q.2d 1025, 1026 (Fed. Cir. 1988) (court relied on extrinsic evidence for an understanding that the applicant's "general merchandise store services" included both department store and grocery services, including the sale of furniture).

Here, testimonial evidence of the operation and features of Opposer's Systems in no way narrows the identification of goods for which Opposer's DA VINCI mark is registered. Instead, it provides clarification of the nature of the "computerized surgical manipulation system"

identified in Opposer's registration of DA VINCI.<sup>9</sup> The identification of goods covered by the registration is certainly sufficiently broad to include all potential features of the Systems, including the imaging/video display feature. *See* ISNR1-1; *In re Jump Designs LLC*, 80 U.S.P.Q.2d at 1374 (where goods are broadly defined in a registration or application, the Board presumes the scope of goods identified therein encompasses all goods of the nature and type described).

Moreover, a senior user can preclude a junior use of the same or similar mark for any goods or services which might reasonably be assumed to emanate from the senior user in the normal expansion of its business under the mark. *Eikonix Corp. v. C.G.R. Medical Corp.*, 209 U.S.P.Q. 607, 613 (TTAB 1981); *In re General Motors Corp.*, 196 U.S.P.Q. 574, 575-76 (TTAB 1977) (expansion of trade doctrine referred to with approval by the Board). Even if the image/video display feature of Opposer's goods were deemed outside the identification of goods in the DA VINCI registration, which it is not, it certainly is part of the normal expansion of Opposer's business - to continue to technologically improve and enhance its goods.<sup>10</sup>

Third, the goods covered by Opposer's registration for DA VINCI (and Opposer's registration of DA VINCI S and applications for DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized), among others), in fact, do include "computerized manipulation system comprised of . . . immersive video display," among other items. ISNR1-1 (emphasis added); ISNR1-2; ISNR1-3; ISNR1-4. The image/video display feature marginalized by Applicant is relevant for purposes of determining the similarity of the parties' respective goods and services.

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<sup>9</sup> In fact, the Board in essence invited Opposer to submit evidence regarding the nature of its goods in its denial of Opposer's motion for summary judgment by ruling therein that "genuine issues of material fact exist as to the relatedness between opposer's identified goods and applicant's identified services." October 27, 2008 Order at p. 4.

The Board's decision in *Synthes (U.S.A.)* is instructive here. In *Synthes (U.S.A.)*, the Board considered an opposition to registration of SYNTHESIS PF for "disposable gloves for medical use" based on a registration for SYNTHES for use with surgical instruments and implants used in bone surgery. 2004 WL 1957205 at \*5. The registrant's surgical goods were purchased by hospitals, among others, and used by surgeons and operating room staff who were trained by the registrant on use of its products. *Id.* at \*6. The Board did not entertain the applicant's argument that its goods were non-sterile gloves not used in surgery because no such limitation existed in the identification of goods covered by the application and, therefore, the application was deemed to cover sterile surgical gloves as well. *Id.* at \*7. Accordingly, the Board determined the parties' respective goods were related because both were used by surgeons and operating room staff and encountered by the same end-users in the same environment. *Id.* at \*7-8. As in *Synthes (U.S.A.)*, surgeons encounter both Opposer's Systems and the services offered under Applicant's Mark simultaneously in the operating room and in relative proximity to one another during the process of treating a patient. The parties' respective goods and services are related and their similarity weighs in favor of Opposer in this case.

**C. The Consumers and Channels of Trade of the Goods and Services Offered Under the Parties' Respective Marks Overlap.**

Applicant argues the consumers of the parties' respective goods and services are distinct for purposes of a likelihood of confusion analysis because they are limited to hospital administrators and patients, respectively, and any overlap is *de minimis*. Applicant's Brief at pp. 23-24. Further, Applicant asserts the parties' trade channels overlap only with regard to the Internet, which is discounted for purposes of a likelihood of confusion analysis, and that any

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<sup>10</sup> That the image/video display feature is available on the DA VINCI S generation of Opposer's goods rather than the DA VINCI generation does not alter the analysis here.

"post-purchase" marketing is not pertinent to the determination of a likelihood of confusion in this case. *Id.* at pp. 25-26. Applicant improperly relies on erroneous interpretations of law and on only select evidence of record in making these assertions, which must fail.

**1. The Consumers of the Parties' Goods and Services Overlap.**

Contrary to Applicant's assertion, for purposes of a likelihood of confusion analysis, the relevant consumers of Opposer's goods are hospitals (including administrators and purchasing agents), surgeons and patients; and relevant consumers of Applicant's services are surgeons, non-surgeon physicians and patients. As the parties' respective registrations and applications contain no restrictions as to consumers, their respective goods and services are presumed to be marketed in all customary trade channels to all customary classes of consumers. *Hewlett Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001 1005 (Fed. Cir. 2002); *Barbara's Bakery Inc.*, 82 U.S.P.Q.2d at 1287; *Eikonix Corp.*, 209 U.S.P.Q. at 613-14. *See* ISNR1-1 through ISNR1-4; DR-3. Nonetheless, Applicant asserts only hospital administrators are relevant consumers of Opposer's goods. Applicant's Brief at p. 23.

Applicant acknowledges, but discounts, that relevant consumers include users who influence purchasing decisions as well as actual and potential purchasers. Applicant's Brief at pp. 22-24 (quoting *Electronic Design & Sales Inc.*, 21 U.S.P.Q.2d at 1390). Further, the question of likelihood of confusion "is not limited to purchasers of the goods [or services] in question but may occur at any stage of the distribution process." *In re Decombe*, 9 U.S.P.Q.2d at 1814-15 (citing *In re Arctic Electronics Co., Ltd.*, 220 U.S.P.Q. 1836 (TTAB 1983) & *In re Optical Int'l*, 196 U.S.P.Q. 775 (TTAB 1977)). In *In re Decombe*, the Board considered and disapproved of the applicant's dismissal of the possibility of confusion among employees and purchasing agents of retailers that sold the parties' goods, distributors, truckers and other transporters of the goods, all in the chain of distribution of the goods from the trademark owner

to the end-user or purchaser. 9 U.S.P.Q. at 1814-15. Non-purchasing end-users are similarly relevant consumers of goods and/or services. *General Motors Corp. v. Keystone Automotive Industr. Inc.*, 79 U.S.P.Q.2d 1456, 1459-60 (6<sup>th</sup> Cir. 2006); *Karl Storz Endoscopy-America v. Surgical Technologies Inc.*, 62 U.S.P.Q.2d 1273, 1276 (9<sup>th</sup> Cir. 1992) (confusion on the part of non-purchasing users, such as surgeons working at hospitals that own a product can establish likelihood of confusion).

In *Synthes (U.S.A.)*, the registrant's surgical instruments and implants were purchased by hospitals, among others, and used by surgeons and operating room staff in those hospitals. 2004 WL 1957205 at \*6. The registrant directed the majority of its sales efforts to surgeons because surgeons recommended their hospitals purchase the registrant's goods and exerted influence in the purchasing decision ultimately made by hospital administrators or purchasing agents. *Id.* Further, the registrant provided training on the use of its goods to surgeons and operating room staff. *Id.* Surgeons also were a class of consumers that used disposable gloves for medical use covered by the application at issue. *Id.* The Board held the relevant consumers of the parties' products overlapped. *Id.* at \*7-8.

The facts here are analogous to those faced by the Board in *Synthes (U.S.A.)*. Opposer's goods are used by surgeons and, as the evidence of record demonstrates, Opposer markets its goods to surgeons who influence and convince hospital administrators to purchase them. Opposer's Brief at p. 12; Applicant's Brief at p. 9. Surgeons also are among the consumers who refer patients to Applicant's licensee, order its services for those patients, receive from Applicant's licensee the resultant images and reports, and use those results as part of their treatment of patients. Opposer's Brief at pp. 24-25. Surgeons are relevant consumers of - and influence hospitals' and patients' respective decisions to purchase - both Opposer's goods and Applicant's services under their respective marks. Further, Opposer promotes its goods directly

to potential patients. *Id.* at pp. 15-18. Potential patients are referred by surgeons and other physicians to Applicant's licensee or may order the services of Applicant's licensee themselves. *Id.* at pp. 24-25. Patients therefore also are relevant consumers of Opposer's goods and Applicant's services. Since surgeons and patients both are consumers of Opposer's Systems and the services covered by the Application, the parties' consumers overlap.

Nonetheless, displaying a misunderstanding of trademark law, Applicant suggests that any consumer overlap here is theoretical or *de minimis*. Applicant's Brief at p. 24. Although Applicant admits the class of consumers of services offered under its Mark includes surgeons, it also asserts that those consumers are *de minimis* as only up to 15 percent of referrals to Applicant's licensee are from physicians outside the physician association of Applicant's licensee. *Id.* This assertion that surgeons actually comprise up to 15 percent of referrals to Applicant's licensee, even if deemed *de minimis*, is an attempt to limit the identification of services in the subject Application, where no such limitation currently exists and where the practices of Applicant's licensee could change in the future.<sup>11</sup> See *Canadian Imperial Bank of Commerce*, 1 U.S.P.Q. 2d at 1814-15. Surgeons customarily use and order diagnostic imaging for their patients and, therefore, are consumers of Applicant's goods, regardless of the level of actual use of Applicant's services by surgeons at this time.<sup>12</sup>

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<sup>11</sup> Applicant also misstates the burden on Opposer here by claiming Opposer has failed to offer evidence of the number of "Surgeon Champions" that refer patients to Applicant's licensee. Applicant's Brief at p.24. There is no requirement that Opposer offer such evidence. It is the class of customary consumers at issue here, not the actual number of surgeon consumers of services under Applicant's Mark.

<sup>12</sup> Further, Applicant's argument is analogous to the assertion that an applicant's shoes are not sold in stores other than its own or a registrant's frozen pre-cooked chicken is not sold in restaurant so there is no overlap of consumers or trade channels with regard to these outlets. The Board has rejected both these arguments. See *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991); *In re Hester Industr., Inc.*, 231 U.S.P.Q. 881, 883 (TTAB 1986).



## **2. Trade Channels for the Parties' Respective Goods and Services Overlap.**

Applicant attempts to avoid the clear overlap of the trade channels through which the parties' goods and services move by ignoring the assumption that each parties' respective goods and services move through all customary channels of trade, by discounting what it refers to as "post-purchase" marketing, and by minimizing the overlap in the parties' trade channels it acknowledges. These attempts are contrary to the law and facts of record.

First, neither Opposer's registrations or applications nor Applicant's application at issue contain restrictions on the trade or marketing channels the parties' may use. *See* ISNR1-1; ISNR1-2; ISNR1-3; ISNR1-4; DR-3. Therefore, for purposes of the likelihood of confusion analysis, all trade and marketing channels customary for the parties' respective goods and services are assumed. *Hewlett Packard Co.*, 62 U.S.P.Q.2d at 1005.

Surgical Systems such as those offered under Opposer's Marks may be marketed in a variety of ways, including sales calls on hospitals and surgeons, attendance at trade shows and medical society meetings, holding of community events, via the Internet, distribution of brochures, videos and DVDs, placement of print advertisements, marketing through hospitals and surgeons who use Opposer's goods, and media coverage. Opposer's Brief at pp. 12-19. Medical diagnostic imaging services such as those offered under Applicant's Mark also may be marketed in a variety of ways, including direct calls on physicians (including surgeons), print advertising, attendance at medical society meetings, distribution of promotional materials such as brochures, business cards, videos and CDs, radio and television commercials, and via the Internet. *Id.* at pp. 22-24. The customary trade and marketing channels of the parties, therefore, overlap as both include sales calls on surgeons, distribution of promotional brochures, attendance at medical society meetings and use of the Internet. Despite Applicant's failure to acknowledge

these customary trade channels, for purposes of this proceeding, the trade and marketing channels of the goods and services offered under the parties' respective marks overlap.

Second, Applicant argues that only Opposer's marketing directed at hospital administrators is relevant here and, inexplicably, that any marketing by Opposer through "da Vinci" hospitals or "da Vinci" surgeons should not be considered because Opposer owns no registration that covers "post-purchase marketing *services* to hospitals and surgeons".

Applicant's Brief at pp. 26-26 (emphasis in original). As described in Section II.C.1 above, relevant consumers of Opposer's goods are not limited to hospital administrators and, instead, include surgeons and patients. Opposer's marketing directed at surgeons and patients, as well as hospital administrators, is relevant in this case.

Applicant appears to assert one must have trademark rights in marketing services for certain marketing activities to be considered by the Board. Applicant's Brief at p. 26. Applicant is misguided. Businesses and trademark owners regularly engage in promotion of goods and services under their marks to build goodwill and recognition among consumers. This importance of marketing activities and their impact on consumers is indicated by their consideration in the determination of likelihood of confusion. Marketing that displays a party's mark in association with its goods, whether pre- or post-sale and whether directly to consumers or to consumers through intermediate entities, is relevant and probative to the likelihood of confusion analysis and should be considered here.

Considering the entirety of both parties' marketing activities of record, the trade channels of the parties' respective goods and services overlap. As described more fully in Opposer's Brief, Opposer itself makes direct sales calls on hospitals and surgeons, attends medical association meetings and trade shows where Opposer makes presentations and distributes brochures and DVDs, sends mobile Systems to community events where it distributes brochures and mans

booths adorned with Opposer's Marks, maintains at least five Internet websites that promote Opposer's Systems offered under its Marks, distributes clinical videos of procedures and procedural techniques using its Systems and videos of patient and surgeon testimonials, and places print advertisements in local newspapers. Through its hospital tool kits, which contain video for use in television commercials and templates for invitations to patient seminars, invitations to referring physician seminars, brochures, billboards, print advertisements and radio and television commercials, Opposer promotes its Systems by assisting "da Vinci" hospitals in their own marketing. Finally, Opposer provides marketing assistance and promotional materials, including brochures and posters, to "da Vinci" surgeons to assist them in expanding their network of referring physicians and patients. *See* Opposer's Brief at pp. 12-19. The evidence of record also shows that Applicant and MSPB have marketed and continue to market services under Applicant's Mark via direct visits to physicians' offices (including those of MSPB and non-MSPB physicians), through distribution of brochures directly to patients, to physicians and at the Center, through attendance at medical association meetings where Applicant's Licensee distributes business cards, via Applicant's Internet website, which describes and promotes the services offered under Applicant's Mark and displays Applicant's Mark on each page, and through MSPB's website, which promotes the services offered under Applicant's Mark and at the Center, in the past referred to the Center as "daVinci" and continues to have a link to Applicant's website. *See Id.* at pp. 22-24.

Both Opposer's sales representatives and Applicant's members visit physicians to promote and sell their respective goods and services. Both parties also attend meetings of medical associations and societies, at which they each distribute marketing materials. Both Opposer and Applicant use brochures as part of their marketing efforts. Finally, both parties

maintain Internet websites that feature their goods and services in association with their respective marks. The parties' trade and marketing channels overlap significantly.

Third, even if one were to ignore marketing by Opposer of its goods through hospitals and surgeons, the parties' trade channels nonetheless overlap in a number of ways, which Applicant has either ignored or attempted to minimize. Specifically, Applicant has failed to mention that both parties make direct sales calls on physicians, distribute marketing brochures directly to patients and physicians, and attend medical society meetings at which they distribute marketing materials. Further, Applicant has suggested that use of the Internet by both parties cannot constitute a "common link" in this case because "virtually every good and service imaginable is advertised on the Internet." Applicant's Brief at pp. 24-25. However, the Internet has been recognized as particularly susceptible to a likelihood of confusion because it allows marks to be encountered simultaneously on the same screen. *GoTo.com, Inc.*, 53 U.S.P.Q.2d at 1657. Both the Internet websites of Opposer and Applicant prominently display the parties' respective marks and both describe and illustrate the parties' respective goods and services. The MSPB Website also promotes the services offered at the Center and includes a link to Applicant's Website. See Opposer's Brief at pp. 23-24. By any measure, the marketing channels through which the parties' goods and services under their respective marks are promoted overlap.

**D. Likelihood of Confusion is Not Obviated Here as a Result of Consumer Sophistication.**

Degree of consumer care is based upon the level of sophistication of the consumers of the products and the cost of the products at issue. *PostX Corp. v. Docspace Co., Inc.*, 80 F. Supp.2d 1056, 1063 (N.D. Cal. 1999). Where goods or services are purchased or used by different classes of consumers, the sophistication and standard of care of those disparate consumers may differ as well. *In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1690-91 (Fed. Cir. 1993) (distinguishing

*Electronic Design & Sales Inc.*, 21 U.S.P.Q.2d at 1388). The standard of care exercised by the reasonably prudent consumer is that of the least sophisticated consumer. *GoTo.com, Inc.*, 53 U.S.P.Q.2d at 1659. For example, the same standard of care is not expected to be exhibited by purchasers of automotive parts from distributors and by purchasers of routine oil change and lubrication services. *In re Shell Oil Co.*, 26 U.S.P.Q.2d at 1691. See also *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) ("the alleged expertise of purchasing agents . . . [is] neither controlling nor persuasive . . . . Confusion had to be considered with respect to users as well as actual purchasers"); *In re Fuji Photo Film Co. v. Shinohara Shoji K.K.*, 225 U.S.P.Q. 540, 542-42 (5<sup>th</sup> Cir. 1985) (purchasers of expensive printing presses are not necessarily sophisticated purchasers when buying low cost graphic arts materials). Further, even sophisticated consumers are not immune to source confusion. *Synthes (U.S.A.)*, 2004 WL 1957205 at \*8; *In re Linkvest S.A.*, 24 U.S.P.Q.2d 1716, 1716 (TTAB 1992).

Surgeons are considered to be fairly sophisticated and knowledgeable about the sources of the surgical products they use.<sup>13</sup> *Synthes (U.S.A.)*, 2004 WL 1957205 at \*8. However, patients also are consumers of Opposer's goods. Further, both surgeons and patients are consumers of the services offered under Applicant's Mark. See Section II.C.1 above. Patients are not sophisticated consumers with regard to Opposer's Surgical Systems or with regard to diagnostic imaging services. While patients may not mistakenly believe Applicant's licensee is the source of Opposer's Surgical Systems, they could easily believe Opposer is the source of the diagnostic imaging services offered under Applicant's Mark. See *In re General Motors Corp.*, 196 U.S.P.Q. at 575-76 (consumers are unlikely to mistakenly believe the registrant is the source

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<sup>13</sup> Applicant states that surgeons know Opposer does not practice medicine. Applicant's Brief at p. 21. However, there is no evidence to this effect in the record and Applicant has cited to none. Applicant's assertion should be disregarded.

of the applicant's motor vehicles but are likely to be mistaken that the applicant car manufacturer is the source of or associated with the registrant's automotive shock absorbers).

In an attempt to bolster its consumer care argument, Applicant suggests both parties' respective goods and services are expensive, the purchase of diagnostic imaging services "is not an impulse decision" and is an "important non-financial decision for the surgeon to diagnose his patient's disease", and the purchase of a Surgical System is a "career-changing and career-expanding decision" for a surgeon and "a very expensive matter the surgeon and hospital "must discuss carefully and wisely together" after "significant study and contractual negotiation."

Applicant's Brief at pp. 27-28. The record contains no evidence to support these statements and Applicant cites none. *Id.* Although there is evidence of record that Opposer's goods are quite costly, the record includes no evidence as to the cost of any of the services offered under Applicant's Mark. While one could assume some disparity in the degree of cost associated with Opposer's goods and the services of Applicant's licensee, no evidence exists to make that determination. The record contains no evidence whether or not the purchase or use of diagnostic imaging services is an impulse decision or regarding the care taken by a surgeon in deciding to order diagnostic imaging for his or her patients. In fact, patients themselves, who are less sophisticated consumers, may order diagnostic imaging services from Applicant's licensee without any involvement by their physicians. Boyle Tr. at 32:15-33:4, 33:7-10. The record also includes no evidence that the purchase of a Surgical System a "career-changing and career-expanding" for a surgeon. In fact, surgeons likely performed surgeries both before and after such a purchase. There also is no evidence of precisely how a hospital reaches its purchasing decisions. Applicant's musings should be disregarded.

**E. Applicant Adopted its Mark Despite Knowledge of Opposer's Marks and Prior Registration.**

A junior user need not intend to confuse consumers for a likelihood of confusion to exist. *GoTo.com, Inc.*, 53 U.S.P.Q.2d at 1658. However, intent to deceive the public is presumed when a junior user knowingly adopts a mark similar to that of another. *Electropix v. Liberty Livewire Corp.*, 60 U.S.P.Q.2d at 1353. As described more fully in Opposer's Brief, Applicant sought registration of and began to use the DAVINCI designation after it became aware of Opposer's registration of DA VINCI and application for DA VINCI S HD SURGICAL SYSTEM (Stylized). Opposer's Brief at pp. 20-21. Applicant has not denied, or even addressed, its prior knowledge of Opposer's Marks. See Applicant's Brief. Accordingly, Applicant's prior knowledge of Opposer's Marks weighs in favor of Opposer. *Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (TTAB 1992).

**F. Opposer's DA VINCI Marks Are The Only Marks Occupying Opposer's Medical/Surgical Niche.**

Applicant states that "evidence of third party use of marks comprised of or including DAVINCI or DA VINCI is probative of the factual issue of whether Opposer's Mark and Applicant's Mark could be confused in a world full of DA VINCI and DAVINCI marks." Applicant's Brief at p. 29. While Applicant is correct that evidence of third party use is probative of the strength of a mark, no such evidence has been proffered here and a determination of a crowded field simply cannot be made on this record.

Evidence of third party registrations alone, such as those submitted here, are not probative of the strength of a mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). Third party registrations are not evidence that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace and, as a result, be able to distinguish between them based on only slight differences. *In re Jump Designs LLC*, 80 U.S.P.Q.2d at 1375; *In re Rocktron Corp.*,

1999 WL 769940 at \*4. Instead, evidence of third party use of similar marks for similar goods or services is required to show a field is crowded. *Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1693. No such evidence has been made of record here.

In fact, Opposer's Marks are not weak. Even if third party registrations constituted evidence of use, which they do not, the third party registrations made of record by Applicant are not for similar marks used in connection with goods or services similar to those of Opposer. Applicant has submitted copies of 93 registrations covering marks that include the terms DA VINCI or DAVINCI. None of these registrations, however, are for goods or services similar to those of Opposer. The majority of third party registrations made of record are for goods or services wholly unrelated to Opposer's Systems. *See* Opposer's Brief at pp. 46-47. Such registrations are irrelevant. *In re Jump Designs LLC*, 80 U.S.P.Q.2d at 1375 (third party registrations for computer services, beverages and athletic shoes are not even remotely related to the furniture covered by the registration are "of no moment"); *In re Rocktron Corp.*, 1999 WL 769940 at \*4; *In re Melville Corp.*, 18 U.S.P.Q.2d at 1389.

Further, none of the registrations specifically addressed by Applicant are in the medical/surgical niche occupied by Opposer's Marks. First, Applicant's reliance on certain registrations for dental ceramics, ceramics for use in cosmetic dentistry, manufacturing of dental veneers and dental laboratory services is misplaced. *See* Applicant's Brief at p. 29. As described more fully in Opposer's Brief, these goods and services do not occupy the medical/surgical field.<sup>14</sup> Opposer's Brief at p. 47. Second, Applicant asserts automated laboratory instruments and machines that make paper are related to Opposer's goods because they possess "robotic

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<sup>14</sup> Applicant inexplicably states that these dentistry goods and services could "easily be classified under the same International Class No. 10" as Opposer's DA VINCI mark. Applicant's Brief at p. 29. Of course, dental goods and services related to dentistry are not properly classified in Class 10. *See* DR-1 at item 20; DR-2 at items 4-7, 22-24, 34 & 55. In any event, the International Class designation does not affect the relatedness of goods and services to one another.



features". Applicant's Brief at p. 29. The identifications of goods in the registrations to which Applicant refers do not include any indication that the subject goods possess "robotic features". See DR-2 at items 27 and 38. The goods covered by these registrations simply are related to Opposer's Surgical Systems. *Id.* Further and as described more fully in Opposer's Brief, DA VINCI is registered in the name of bioMerieux, B.V. for discrete photometric analyzers (referred to as automated laboratory instruments by Applicant). These goods are instruments used in laboratories to measure analytes and are not in the medical/surgical niche. In fact, by opposing its application, Opposer obtained an agreement from bioMerieux that it would use its mark only for discrete photometric analyzers and not expand its business under the mark to enter Opposer's niche. Opposer's Brief at pp. 46-47. None of the third party registrations made of record are for goods or services similar or related to those of Opposer. This factor weighs in Opposer's favor.

**G. Actual Confusion is Unnecessary for a Finding of Likelihood of Confusion.**

Applicant asserts there have been no instances of actual confusion and, therefore, a finding of likelihood of confusion is not supported in light of the parties' concurrent use of their respective marks. Applicant's Brief at p. 29. However, it is well-settled that evidence of actual confusion is not necessary for a showing of likelihood of confusion or to prevail in an opposition proceeding such as this. *GoTo.com, Inc.*, 53 U.S.P.Q.2d at 1658.

## **II. CONCLUSION**

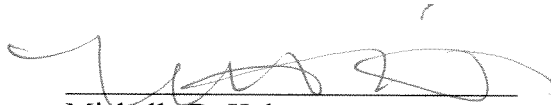
For the foregoing reasons and those set forth in Opposer's Brief, Opposer Intuitive Surgical, Inc. respectfully requests that this Board sustain this opposition and preclude

registration on the Principal Register of Applicant's Mark DAVINCI DIAGNOSTIC IMAGING  
& Design.

Dated: September 22, 2009

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|                               | ) |                              |
| Opposer,                      | ) | Opposition No. 91175319      |
|                               | ) |                              |
| v.                            | ) | Serial No. 78/728,786        |
|                               | ) |                              |
| DAVINCI RADIOLOGY ASSOCIATES, | ) | Published: December 19, 2006 |
| P.L.,                         | ) |                              |
|                               | ) |                              |
| Applicant.                    | ) |                              |

APPENDIX OF AUTHORITIES IN SUPPORT OF  
OPPOSER INTUITIVE SURGICAL, INC.'S REPLY TRIAL BRIEF

Opposer Intuitive Surgical, Inc. ("Opposer") hereby submits this Appendix of Authorities in support of its Reply Trial Brief. Copies of the following authorities cited in Opposer's Reply Trial Brief are attached hereto as follows:

TRADEMARK TRIAL AND APPEAL BOARD NOTICES

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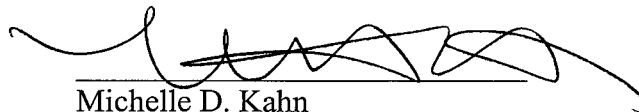
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(TTAB Aug. 18, 2004)

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Dated: September 22, 2009

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# TAB 1

## United States Patent and Trademark Office OG Notices: 23 January 2007

### Citation of Opinions to the Trademark Trial and Appeal Board

It has been the policy of the Trademark Trial and Appeal Board (TTAB) that TTAB opinions not designated as precedential should not be cited to the TTAB and, if cited, are disregarded. E.g., *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992). The TTAB is changing its policy with respect to the citation of opinions not designated as precedential. Accordingly, the Board will henceforth permit citation to any TTAB disposition as follows:

- . The TTAB will continue its current practice of designating all final decisions as either precedential or not precedential. Unless specifically designated as precedential, an order on a motion should be considered not precedential.

- . The TTAB will continue its practice of considering precedential decisions as binding upon the TTAB.

- . A decision designated as not precedential is not binding upon the TTAB but may be cited for whatever persuasive value it might have.

- . Citation to all TTAB decisions should be to the United States Patent Quarterly, if the decision appears therein; otherwise, to a USPTO public electronic database. If a non-precedential decision does not appear in the United States Patent Quarterly or the USPTO's public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited.

- . Decisions of other tribunals may be cited to the extent allowed and for the purposes permitted by the tribunal that issued the decision.

The TTAB will continue to post all its final decisions at:

<http://des.uspto.gov/Foia/TTABReadingRoom.jsp>. The files of TTAB proceedings are available at: <http://ttabvue.uspto.gov/ttabvue/>.

In due course, the TTAB will make revisions to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) consistent with this notice.

December 27, 2006

J. DAVID SAMS  
Chief Administrative Trademark Judge

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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

IN RE ROCKTRON CORPORATION

Serial No. 74/531,669

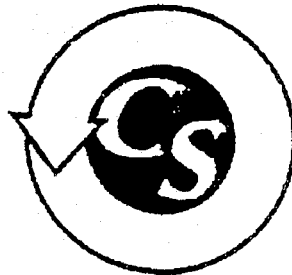
August 31, 1999

Robert A. Dunn of Dinnin &amp; Dunn, P.C. for Rocktron Corporation.

Loretta C. Beck, Trademark Examining Attorney  
Law Office 102  
(Thomas V. Shaw, Managing Attorney).

Before Seeherman, Walters and Bottorff  
Administrative Trademark Judges.  
Opinion by Bottorff  
Administrative Trademark Judge:

Applicant seeks registration of the mark depicted below



for goods identified as "electronic audio signal processing components, namely encoders and controllers for surround sound or home theater sound recording, and decoders for surround sound or home theater playback."<sup>[FN1]</sup>

Registration has been refused under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that applicant's mark, as applied to applicant's goods, so resembles the mark CS (in typed form), for goods identified as "amplifiers,"<sup>[FN2]</sup> as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, applicant appealed. Applicant and the Trademark Examining Attorney filed briefs, but applicant did not request an oral hearing. We affirm the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we find that applicant's mark and the registered mark share the same dominant feature, i.e., the letters "CS". These letters appear to be arbitrary as applied to the goods identified in the application and in the registration, without any special meaning in the industry.<sup>[FN3]</sup> They comprise the whole of the registered mark, and they are the literal portion of applicant's mark which would be used by purchasers to refer to or call for applicant's goods. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Indeed, it appears from applicant's specimens of use that applicant itself often uses merely the letters "CS" to refer to its goods, i.e., "CS is a 4-2-4 matrix system, which is how broadcast and storage can be realized within two-channel mediums"; and "[i]n terms of audio, CS is of the highest possible standard." (Emphasis in original.)

\*2 Thus, we find that the marks at issue are identical in terms of their sound. Comparing the marks next in terms of appearance and commercial impression, we note that applicant's mark includes a design element which is not present in the registered mark, i.e., a circular arrow device within which the letters "CS" are enclosed. Applicant argues that this design element plays a large role in the commercial impression of applicant's mark, in that it connotes or suggests that applicant's goods employ surround-sound technology. However, it is because of this suggestive significance of the design element that the letters "CS" form the dominant part of applicant's mark.

Moreover, because the registered mark is depicted in typed form, registrant would be entitled to display the mark in various forms, including enclosure of the letters "CS" in a circular carrier device. See *In re Fisher Tool Co., Inc.*, 224 USPQ 796 (TTAB 1984). Although applicant's mark would not be identical in appearance to registrant's mark as so displayed, the marks nonetheless would be similar in terms of appearance and commercial impression, in that they both would consist of the arbitrary letters "CS" enclosed within, or surrounded by, a circular carrier device.

In short, when we consider the marks in their entirety in terms of their appearance, sound, meaning and overall commercial impression, we find that they are similar, rather than dissimilar. This similarity of the marks weighs

in favor of a finding of likelihood of confusion.

We turn next to a determination of whether applicant's goods, as identified in the application, are sufficiently closely related to the goods identified in the cited registration that source confusion would be likely to result from the use of similar marks on such goods. We find that the requisite commercial relationship between applicant's goods and registrant's goods exists in this case.

Initially, we must address applicant's argument that although registrant's goods are identified broadly in the registration as "amplifiers," in actual fact registrant uses the registered mark only on "guitar amplifiers," goods which applicant asserts are highly dissimilar from the sophisticated audio equipment on which applicant is using its mark. Applicant has submitted the declaration of its officer Robert Waller as evidence in support of this contention. Citing 1% in *re* *Trackmobile, Inc.*, 15 USPQ2d 1152 (TTAB 1990), applicant argues that the Board's determination of whether applicant's goods are related to registrant's goods should take into account this extrinsic evidence as to the limited scope of the registrant's actual goods.

*In re Trackmobile, Inc.*, *supra*, is inapposite to the present case. Unlike the situation presented in *Trackmobile*, where the Board was uncertain as to the very nature of the "light railway motor tractors" identified in the registration at issue, in the present case the Board does not need the benefit of extrinsic evidence in order to ascertain what "amplifiers" are. The Board therefore will accord to the word "amplifiers" its normal, ordinary commercial meaning, and presume that registrant is entitled to use its mark on any and all "amplifiers," not just "guitar amplifiers."<sup>[FN4]</sup>

\*3 The evidence of record shows that the term "amplifiers" is used to refer to certain components which would be used in conjunction with or as part of surround-sound audio systems. Indeed, applicant has admitted that its decoder must be used with an amplifier in order to function properly. Thus, we find that surround-sound components such as applicant's and amplifiers such as those identified in the registration are complementary and thus related products.

Moreover, even if we were to limit registrant's goods to "guitar amplifiers," as suggested by applicant, we would still find the goods to be related. The evidence of record in this case clearly shows that applicant markets its goods to musicians involved in the live performance of music and in the producing and recording of music. These are the same purchasers to whom "guitar amplifiers" would be sold.<sup>[FN5]</sup>

For example, applicant's specimens state that applicant's surround-sound system "is the first surround sound system designed specifically for *music production*" (emphasis in original); that applicant's system "opens the wildly expanding surround market to the musician/producer, at an extremely affordable price"; that applicant's surround-sound encoder includes features "allowing it to optimally interface with all pro and semi-pro recording gear" (emphasis added);<sup>[FN6]</sup> and that applicant's system "has established itself within virtually every audio arena: major recording studios, live performance venues, theme parks, and automotive and home audio." (Emphasis added.) Similarly, applicant's brochure entitled CIRCLE SURROUND, submitted with the March 6, 1996 Declaration of Robert Waller, states that applicant's system "can let the studio owner, broadcaster, film maker, convention or trade show presenter, video game creator and concert artist affordably enter this rapidly expanding world of true sonic and spatial realism" (emphasis added); and that "[p]roducing in CS is quite simple. Any mixer with a stereo program bus and a couple of aux sends can be used."<sup>[FN7]</sup>

In short, the record shows that applicant's goods are commercially related to the "amplifiers" identified in the cited registration, even if we were to construe registrant's "amplifiers" so narrowly as to encompass only "guitar amplifiers." This relationship between the respective goods, especially when considered in light of the confusing similarity of the marks, warrants a finding that confusion is likely in this case.

We have carefully considered all of applicant's arguments with respect to the other *du Pont* likelihood of confusion factors, but we are not persuaded that the evidence of record as to any of those other factors significantly favors applicant, or that it is sufficient to counterbalance, in our likelihood of confusion analysis, the similarity of the marks and commercial relationship between the goods.

Briefly stated, we are not persuaded on this record that the normal trade channels for applicant's goods do not overlap with the normal trade channels for the goods identified in the registration, given the complementary nature of the goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Nor are we persuaded on this record that purchasers of the types of goods identified in the application and in the registration are necessarily sophisticated purchasers or, more importantly, that they necessarily would be immune to source confusion when faced with the similar marks and related goods involved in this case. See *Refreshment Machinery Incorporated v. Reed Industries, Inc.*, 196 USPQ 840 (TTAB 1977).

\*4 Furthermore, the third-party registrations of marks consisting or comprised of the letters "C" and "S" are entitled to little weight in our likelihood of confusion analysis. (Because the Trademark Examining Attorney has not objected to applicant's third-party registration evidence on the ground that it was submitted in the form of a commercial search report, we have considered the evidence.) The third-party registrations submitted by applicant do not establish that the marks depicted therein are in use in commerce or that they are familiar to consumers, and, moreover, none of the registrations appears to be for goods which are similar to the goods involved in this case.

The fact that applicant is unaware of any instances of actual confusion does not persuade us that there is no likelihood of confusion in this case. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. Moreover, the alleged absence of actual confusion is entitled to little weight in our likelihood of confusion analysis because we cannot determine on this record that there has been any meaningful opportunity for actual confusion to have occurred in the marketplace. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

Finally, it is not dispositive that registrant's mark may not be famous, nor are we persuaded on this record that the strength of applicant's mark is such as to weigh significantly against a finding of likelihood of confusion in this case.

In short, after carefully considering all of the evidence of record pertaining to the relevant *du Pont* factors, we conclude that confusion is likely in this case.

Decision: The refusal to register is affirmed.

E. J. Seeherman

C. E. Walters

C. M. Bottorff

Administrative Trademark Judges Trademark Trial and Appeal Board

FN1. Application Serial No. 74/531,699, filed May 31, 1994. The application is based on applicant's allegation of use in commerce since December 1, 1993.

FN2. Registration No. 1,486,017, issued April 26, 1988. Affidavits under Trademark Act Sections 8 and 15 accepted. The record owner of the registration is Peavey Electronics Corporation.

FN3. Applicant argues that the letters "CS" stand for or are an abbreviation of the term "Circle Surround," which is the name of applicant's surround-sound system, and that they would be used by applicant in conjunction with applicant's CIRCLE SURROUND mark. However, the words CIRCLE SURROUND are not part of the mark sought to be registered here, so they cannot be considered in our determination of the significance or connotation of applicant's mark.

FN4. As acknowledged by applicant in its April 28, 1995 response to the first office action refusing registration, if applicant believed the identification of goods in the cited registration to be overly broad, applicant's remedy would have been to file an action for partial cancellation of that registration. *See, e.g., Eurostar, Inc. v "EuroStar" Reitmoden GmbH & Co KG*, 34 USPQ2d 1266 (TTAB 1994).

FN5. Additionally, we note that applicant's vice-president, Mr. Waller, states that "[a] segment of Rocktron's product line is directed toward signal processing for live music performances, particularly for electric guitar players in the rock and roll music genre." (Declaration of Robert Waller (March 6, 1996) at page 1.) It is unclear whether applicant markets these products to guitarists under the mark at issue in this case. However, the fact that applicant's product line includes both the surround-sound components identified in the application and audio equipment made specifically for electric guitarists further supports a finding that purchasers would be likely to perceive a source connection between such goods.

FN6. The Wonderland Music Superstores advertisement submitted by applicant with its response to the first office action displays a guitar amplifier made by registrant immediately adjacent to the "424 Portastudio," a portable recording studio which would appear to be the sort of "semi-pro recording gear" with which applicant's surround-sound components may "optimally interface." The significance of the numerals "424" as used in "424 Portastudio" is not clear from the record, but the Board notes that applicant, in its specimens of use, describes its system as "a 4-2-4 matrix system." *See supra* at page 4.

FN7. It is unclear whether the "424 Portastudio" advertised in the Wonderland Music Superstores advertisement might be the sort of "mixer" with which applicant's components can be used. *See discussion supra* at footnote 6.

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2004 WL 1957205 (Trademark Tr. &amp; App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

SYNTHES (U.S.A.)  
v.  
CYPRESS MEDICAL PRODUCTS, L.P.

Opposition No. 91123720  
Cancellation No. 92031730

August 18, 2004

Nancy Zoubek of Jones Day for Synthes (U.S.A.)<sup>[FN1]</sup>

Jeffrey A. Pine of Baniak Pine &amp; Gannon for Cypress Medical Products, L.P.

Before Hairston, Chapman and Bottorff  
Administrative Trademark Judges  
Opinion by Bottorff  
Administrative Trademark Judge:

**INTRODUCTION**

The above-captioned opposition and cancellation proceedings were consolidated by order of the Board dated September 30, 2002. Synthes (U.S.A.) is the opposer and petitioner in the respective cases, and in this decision we shall refer to it as opposer/petitioner or as plaintiff. Cypress Medical Products, L.P. is the applicant and the respondent in the respective proceedings, and in this decision we shall refer to it as applicant/respondent or as defendant. Because the opposition and the cancellation involve the same parties and common questions of law and fact, we shall decide them both in this single opinion, which shall be entered in both proceeding files.

In the application involved in the opposition proceeding, defendant seeks registration on the Principal Register of the mark SYNTHESIS PF (in typed form) for Class 10 goods identified in the application as "disposable gloves for medical use."<sup>[FN2]</sup> Defendant's registration, involved in the cancellation proceeding, is of the mark SYNTHESIS (in typed form), and is likewise for "disposable gloves for medical use."<sup>[FN3]</sup>

On January 25, 2001, plaintiff filed a notice of opposition to defendant's pending application and a separate petition to cancel defendant's registration, asserting in both cases a Section 2(d) claim of priority and likelihood of confusion as its ground for opposition and cancellation, respectively. Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>[FN4]</sup> Specifically, plaintiff alleged that it is the prior user of the trade name and trademark SYN-

THES on or in connection with instruments and apparatus for surgical, medical and veterinary purposes; that it is the owner of Registration No. 999397, which is of the mark SYNTHES (in typed form) for Class 10 goods identified in the registration as "instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery, namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints; injection needles, and gum plates";<sup>[FN5]</sup> and that each of defendant's marks, as applied to the goods identified in defendant's application and registration, so resembles plaintiff's trade name and trademark SYNTHES as to be likely to cause confusion, to cause mistake or to deceive.

Defendant answered the notice of opposition and the petition for cancellation by denying the salient allegations thereof.<sup>[FN6]</sup>

\*2 At trial, plaintiff submitted the testimony depositions of its officers Stephen Schwartz (Senior Vice-President) and Michele Zaborowski (Comptroller) and the exhibits thereto; the testimony deposition (under subpoena) of Thresa Waite (defendant's Director of Marketing) and the exhibits thereto; and, under Notice of Reliance, a status and title copy of its pleaded Registration No. 999397, and copies of the file histories for registrations of various other marks which are owned by defendant. For its part, defendant submitted the testimony deposition of Timothy Sabatka (its Chief Financial Officer and Chief Operating Officer) and the exhibits thereto (including printouts of third-party registrations and applications from the USPTO's electronic database).

The consolidated opposition and cancellation have been fully briefed, but no oral hearing was requested.

#### **PAPERS IMPROPERLY FILED UNDER SEAL; REDACTED COPIES DUE IN 30 DAYS**

A preliminary issue with respect to the record herein requires discussion. Trademark Rule 2.27(e), 37 C.F.R. §2.27(e), provides that "when possible, only confidential portions of filings with the Board shall be filed under seal." A similar provision also appears in the parties' own protective agreement, and the Board expressly reminded the parties of this requirement in its order entering that protective agreement. Despite this requirement, the parties submitted the above-referenced testimony depositions (with exhibits), as well as their briefs, entirely under seal. Such submission of entire filings under seal, including obviously non-confidential portions thereof, is improper. The Board telephoned counsel for each party and required them to resubmit their filings in compliance with Trademark Rule 2.27(e), i.e., with only the confidential portions thereof filed under seal.

In response, applicant's counsel has submitted a properly-redacted copy of the testimony deposition of Timothy Sabatka (and exhibits thereto). However, applicant has not submitted a redacted copy of its brief, and opposer has failed to resubmit any of its filings. To avoid further delay in issuance of a final decision in these cases, the Board, in preparing this opinion, has used its best judgment as to what information in the parties' papers can reasonably be deemed to be confidential, and has refrained from relating such confidential information in the opinion.

However, the parties are allowed until **thirty days** from the date of this decision to submit properly redacted copies of their filings, with only the confidential portions thereof filed under seal. Such filings may be made electronically via ESTTA, or may be made on paper or on CD-ROM in accordance with Trademark Rule 2.126. *See generally* TBMP §106.03 (2d ed. rev. 2004). If no such redacted copies are filed within the time allotted, the filings which currently are improperly filed entirely under seal shall be unsealed and entered into the public record of these proceedings. *See* Trademark Rule 2.27(a); TBMP §106.03.

**DEFENDANT'S MOTION TO STRIKE**

\*3 As an exhibit to its reply brief, plaintiff submitted (for the first time) a copy of an assignment document, executed and recorded in 1984, which effects the assignment of its pleaded Registration No. 999397, *inter alia*, from Synthes AG, a Swiss corporation and the original owner of the registration, to Synthes Ltd. (U.S.A.), apparently another predecessor in title to plaintiff. Applicant filed a motion to strike this evidence on the ground that it is untimely, and plaintiff has contested the motion. In an interlocutory order, the Board deferred consideration of the motion until final decision.

We grant defendant's motion to strike. The evidence attached to plaintiff's reply brief was not made of record during trial, and it therefore cannot be made of record by attachment to plaintiff's brief. *See* TBMP §704.05(b)(2d ed. rev. 2004), and cases cited therein.<sup>[FN7]</sup>

**STANDING**

Turning now to the merits of the case, plaintiff has made of record a status and title copy of its pleaded Registration No. 999397 which shows that the registration is extant and is owned by plaintiff. In view thereof, and because plaintiff's likelihood of confusion claim is non-frivolous, we find that plaintiff has established its standing to bring these proceedings. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

**SECTION 2(d) GROUND: PRIORITY**

For purposes of the opposition proceeding, priority is not at issue with respect to the goods identified in plaintiff's pleaded registration, i.e., "instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery, namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints; injection needles, and gum plates." *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, as to both the opposition and the cancellation proceedings, petitioner has proven that it has used SYNTHES in commerce since 1975, both as a trade name and as a trademark on the goods identified in its registration and on various accessory and ancillary goods (such as storage cabinets and trays, power tools used for bone surgery, etc.).<sup>[FN8]</sup> Such use predates defendant's application filing dates and its alleged dates of first use. We therefore find that to the extent that priority is at issue in these cases, plaintiff has established such priority for purposes of both the opposition proceeding and the cancellation proceeding.

**SECTION 2(d) GROUND: LIKELIHOOD OF CONFUSION**

The remaining issue for determination is whether plaintiff has established that defendant's marks, as applied to the goods identified in the involved application and registration, so resembles plaintiff's registered and/or previously-used SYNTHES mark and trade name as to be likely to cause confusion. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We also must bear in mind that the fame of a plaintiff's mark, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

\*4 We make the following findings of fact as to each of the pertinent *du Pont* factors.

#### Similarity of the Marks

We first must determine whether defendant's marks (SYNTHESIS and SYNTHESIS PF) and plaintiff's mark (SYNTHES), when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Initially, we find that in defendant's mark SYNTHESIS PF, the dominant feature of the mark is the word SYNTHESIS. The letters PF, which stand for the descriptive or generic designation "powder free," contribute relatively little to the commercial impression of the mark, either in terms of appearance, sound or connotation. For this reason, we give more weight to the dominant feature SYNTHESIS and less weight to the letters PF when we compare defendant's mark to plaintiff's mark. Although we do not ignore these letters and instead consider applicant's mark in its entirety, we find that the fact that they appear in defendant's mark but not in plaintiff's mark does not suffice to distinguish the marks in terms of their overall source-indicating commercial impressions. *In re National Data Corp.*, *supra*.

In terms of appearance, we find that each of defendant's marks is more similar than dissimilar to plaintiff's mark. The marks share the same seven first letters (SYNTHES). They differ only in that defendant's marks add the letters -IS at the end of SYNTHES, and in that the mark in defendant's pending application includes the descriptive and disclaimed letters PF. We find that these points of dissimilarity are outweighed by the similarity in appearance which arises from the presence of SYNTHES at the start of each of the marks.

In terms of sound, we again find that each of defendant's marks is more similar than dissimilar to plaintiff's mark. The first (and/or only) word in defendant's marks would be pronounced as the word "synthesis." The evidence shows that plaintiff prefers to pronounce its mark as "sinth-aze," but it is settled that there is no "correct" pronunciation of trademarks because the manner in which purchasers will pronounce such marks cannot be predicted with certainty. *See, e.g., In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985); and *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983). Indeed, the evidence shows that plaintiff's customers pronounce plaintiff's mark in a variety of ways, such as "sinth-eez" or "sinth-ess" or "sinth-uss." These last two pronunciations, which are entirely plausible, would be identical to the common pronunciation of the first two syllables of the word "synthesis" in defendant's marks. The final syllable of that word merely adds to the succession of sibilants spoken in the first two syllables, and does little to distinguish the parties' marks aurally. The letters PF in defendant's SYNTHESIS PF mark do not appear and thus would not be vocalized in plaintiff's mark, but that difference does not suffice to distinguish the marks, given the descriptive significance of those letters as applied to defendant's goods. On balance, we find that the marks sound more similar than dissimilar.

\*5 In terms of connotation, we find, again, that the marks are more similar than dissimilar. Obviously, defendant's marks connote the word "synthesis," i.e., "the composition or combination of parts or elements so as to form a whole." (Webster's Ninth New Collegiate Dictionary (1990) at 1198.<sup>[FN9]</sup> We find that plaintiff's mark SYNTHES would readily be perceived by purchasers as a truncation or derivative of the same word, i.e., "synthesis." The mark consists of the first seven letters of the word "synthesis," and it has no apparent other meaning. This purchaser perception or understanding is especially likely given the nature of plaintiff's goods, which are identified in plaintiff's registration as "instruments and implants for osteosynthesis."<sup>[FN10]</sup> (Emphasis added.) The letters PF in defendant's SYNTHESIS PF mark connote "powder free," a descriptive or generic designation which contributes little or nothing to the mark's source-indicating function. Any dissimilarity in connotation which results from the presence of those letters in defendant's mark and their absence from plaintiff's mark is greatly outweighed by the basic similarity in connotation which arises from the fact that both marks mean, or would be perceived as being derived from, the word "synthesis."

For the reasons discussed above, we find that when the parties' marks are compared in their entirety, they are more similar than dissimilar in terms of their overall commercial impressions. The first *du Pont* factor thus weighs in plaintiff's favor.

#### Similarity of the Goods, Trade Channels and Purchasers

We turn next to a consideration of the second and third *du Pont* factors, i.e., the similarity or dissimilarity of the parties' goods, the trade channels in which those goods are marketed, and the classes of purchasers to whom they are marketed. We note generally that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Plaintiff's goods, as identified in plaintiff's registration, are "instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery, namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints; injection needles, and gum plates." Plaintiff's witness Mr. Schwartz testified that plaintiff

\*6 ...is in the business of what you might call skeletal fixation which is fracture fixation using operative, surgical intervention and different appliances or components or implants to fasten the fracture pieces back together. Synthes is also involved in some reconstructive orthopedic surgery and any type of skeletal fixation that would, basically, go from head to toe from the maxillofacial skeleton to the normal axial skeleton and also including spine surgery.

(Schwartz Depo. at 5-6.) He also testified that

[a]ny hospital that has an active orthopedic or maxillofacial or spine service will use Synthes' products in some way, shape or form. Additionally our products are also used in short stay surgical centers and also in doctors' offices where they would do a day-surgery procedure. It could be something as simple as going in to have a screw put into your hand for a relatively simple fracture that could be done on the same day basis. Or it could be something as involved as a major spine reconstruction or pelvis reconstruction that would be

done at a major acute care facility. The spectrum is very broad and our products are used - kind of across the board in those different types of operating rooms and hospitals.

(Schwartz Depo. at 25.) This testimony as to the nature and range of plaintiff's products is borne out by the exhibits to Mr. Schwartz' testimony, which include catalogs and price lists covering a large variety of bone surgery implants and instruments in a variety of sizes, as well as accessory items such as power tools and storage trays and cases. Plaintiff's goods range from individual screws and plates costing around ten dollars to complete sets of implants and instruments, costing many thousands of dollars, which are used in complex bone surgery procedures. (See, e.g., Schwartz Depo., Exh. Nos. 5, 11.)

As shown by the testimony quoted above, plaintiff's skeletal fixation products are purchased and used by hospitals, clinics, outpatient surgery centers, and doctors' offices. Plaintiff markets its products through its force of over six hundred salespeople, who not only sell the products but who also are present in the operating room during surgery, offering to the surgeons and the operating room staff their expertise in the proper use of the implants and instruments. (Schwartz Depo. at 23-24.) In the hospital setting, plaintiff's salespeople meet with surgeons, with operating room staff, with central supply staff who clean and process the equipment, with purchasing department personnel, and with hospital administrative personnel. However, plaintiff's salespeople direct the vast majority (seventy-five percent) of their sales efforts to surgeons, because although the final decision to purchase the products is made by the hospital's administration or purchasing department, it is the surgeons who recommend the purchase and who exercise the greatest influence in the hospital's decision to purchase the products. (Schwartz Depo. at 97-100.)

\*7 Defendant's goods, as identified in the involved application and registration, are "disposable gloves for medical use."<sup>(FN11)</sup> Defendant argues that the gloves it actually sells are non-sterile and thus would not be used in a surgical environment. However, our likelihood of confusion determination must be made on the basis of the goods as identified in the application and registration, regardless of what the evidence shows to be the actual goods currently marketed by defendant. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Thus, the "disposable gloves for medical use" identified in defendant's application and registration must be deemed to include sterile surgical gloves. Such gloves are used by surgeons and operating room staff, the same persons who use plaintiff's bone surgery products.

Defendant sells its gloves to healthcare product distributors, who then sell the gloves to some of the same end purchasers who purchase plaintiff's products, i.e., to hospitals, outpatient surgery centers, and doctors' offices. (Sabatka Depo. at 31.) In doctors' offices, it is the doctor who makes the decision to purchase the gloves, while in larger settings such as hospitals the purchasing decision is made by the purchasing department. (Sabatka Depo. at 48.)

Comparing the parties' goods, trade channels and purchasers, we find that although applicant's gloves and plaintiff's bone surgery products are not competitive or interchangeable products, they nonetheless are sufficiently related in the marketplace that confusion is likely to occur if the products are sold under similar marks. There is an overlap in the end users of the respective products, i.e., both parties' products are used by operating room surgeons and staff in the operating room environment, and by doctors and nurses in the outpatient center and doctor's office settings. We also find that the relevant class of purchasers for the respective goods is the same or overlapping. In the doctor's office setting, the decision to purchase both parties' products likely would

be made by the doctor. However, it is likely that once the decision to purchase a particular vendor's products is made by the doctor, the actual ordering of the goods and maintenance of the office's inventory of such goods is done by clerical personnel, not by the doctor.

The same is true in the hospital setting. Initially, it is the surgeon who influences the hospital's decision to purchase plaintiff's bone surgery products, especially the more expensive complete sets of implants and instruments used for complicated procedures. However, once the initial decision to use plaintiff's products is made, the hospital must maintain an inventory of implants, instruments and accessories, in all necessary sizes. (Schwartz Depo. at 73-75.) Such routine and continuing purchases of plaintiff's products likely are authorized and made not by the surgeon directly, but by the hospital's purchasing office or other personnel in charge of maintaining the inventory, in collaboration with or at the request of the operating room department. The hospital's inventory of disposable surgical gloves likewise would be maintained by the purchasing office, which would order the goods in collaboration with or at the request of the operating room department. Thus, plaintiff's products and defendant's products both are used by the operating room department of the hospital, and it is that department on whose behalf the hospital's purchasing department makes the actual purchases of the respective goods. The facts of this case therefore are distinguishable from those in the cases of *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), and *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983). In those cases, the respective goods of the parties were used by different departments in the hospital, and the decision to purchase the respective products was made or influenced by those different departments.

\*8 In short, we find that the parties' respective goods are related insofar as they are encountered and used by the same end users, i.e., by doctors and nurses in doctors' offices, and by surgeons and operating room staff in the hospital operating room environment. Doctor's office personnel and hospital operating room personnel are likely to encounter, in the doctor's office or in the operating room environment, both storage cases and trays containing plaintiff's products and bearing plaintiff's mark, and boxes of disposable gloves bearing defendant's marks. We also find that the relevant purchasers of the goods overlap. In doctors' offices, these would be the doctors who make the decision to purchase the products and the clerical personnel who actually order the goods and maintain the inventory. In the hospital setting, the purchasers would be the surgeons in the operating room department, as well as the hospital's purchasing department which, in collaboration with or at the request of the operating room department, must maintain the proper level of inventory of the products.

On balance, we find that the parties' goods, and the trade channels and classes of purchasers for those goods, are sufficiently related that the second and third *du Pont* factors weigh in favor of a finding of likelihood of confusion.

#### **Purchasing Conditions and Sophistication of Purchasers**

Defendant's disposable medical gloves are inexpensive goods, retailing for four to seven dollars per box of one hundred, or four to seven cents per glove. (Sabatka Depo. at 30.) Plaintiff's products range in price from around ten dollars per unit for individual screws and plates to many thousands of dollars for complete sets of implants and instruments used in complicated surgical procedures. (See, e.g., Schwartz Depo., Exh. Nos. 5, 11.) Plaintiff directs most of its marketing efforts to surgeons, who have a great amount of influence on the initial decision to purchase plaintiff's products. It is reasonable to assume that these surgeons are fairly sophisticated and knowledgeable about the sources of the bone surgery products they use and recommend for purchase, especially given



the fact that plaintiff's salespeople deal with the surgeons directly in sales calls and in the operating room during surgery using the products.

As discussed above, however, it is likely that the responsibility for maintaining the proper level of inventory of plaintiff's implants and instruments falls not to the surgeon but rather to other operating room staff or hospital purchasing personnel, who may not have the benefit of the salesperson's personal attention when ordering the goods. These are the same persons who would be responsible for purchasing and maintaining the hospital's inventory of disposable medical gloves. We cannot assume that these hospital personnel are as sophisticated or knowledgeable as surgeons would be with respect to the sources of the goods or the trademarks under which they are sold. In any event, it is settled that even sophisticated purchasers are not immune to source confusion which would otherwise result from the use of confusingly similar marks. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). We find that the fourth *du Pont* factor weighs in plaintiff's favor.

#### Fame of the Prior Mark

\*9 The fifth *du Pont* evidentiary factor requires us to consider evidence of the fame of plaintiff's mark, and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, *supra*; and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.* *Bose Corp. v. QSC Audio Products Inc.*, *supra*, 63 USPQ2d at 1305.

In this case, we find that plaintiff's SYNTHES mark indeed is a famous mark, for purposes of the fifth *du Pont* evidentiary factor. Plaintiff has used its mark in the United States for decades. (Schwartz Depo. at 7-8.) It is true, as defendant argues, that plaintiff engages in no traditional advertising of its products. (*Id.* at 35, 80.) However, that does not mean that plaintiff engages in no marketing of its products. The dollar amount of plaintiff's marketing expenditures has been submitted under seal and will not be specified here, but we find without doubt that it is a quite impressive number. (Zaborowski Depo. at 7-8; Exh. No. 29.) Plaintiff actively markets its products to eighty percent of the hospitals in the United States. (Schwartz Depo. at 34.) Its salespeople are a common sight in the operating room environment. (*Id.* at 23-24.) Its catalogs and other literature, including procedure technique guides, are kept and used as references in hospital operating rooms around the country. (*Id.* at 21-22, 55-56.) Plaintiff sponsors an extensive program of continuing medical education activities (*id.* at 80-81), and it is a prominent presence at fifty trade shows and medical conventions per year, including all of the major shows and conventions in the industry. (*Id.* at 64-71; Exh. Nos. 24-25.)

\*10 As a result of these extensive marketing activities, plaintiff dominates the market in all aspects of the skeletal fixation field. (Schwartz Depo. at 59-60, 72-73.) In the April 2002 issue of *Orthopedic Network News*, a trade journal, plaintiff was identified as the United States market leader in the sale of trauma products<sup>[FN12]</sup> in 2000-01, with a market share of over forty-five percent. (The next largest competitor was reported to have had a

market share of fourteen percent.) Plaintiff's share of the market for bone surgery screws and plates is reported to have been over seventy-two percent. (Schwartz Depo. at 61-63, 71-73; Exh. No. 23.) Mr. Schwartz, plaintiff's Senior Vice-President, testified that under plaintiff's own estimates, plaintiff's current market share is even higher. (*Id.* at 59-61.) Plaintiff's sales figures for 1997-2001 have been submitted under seal and will not be specified here, but there can be no question that they are quite impressive. (Zaborowski Depo. at 7-8; Exh. No. 29.)

Based on this evidence, we find that plaintiff's SYNTHES mark and trade name are famous among the relevant purchasers at issue in this case. We find that the fifth *du Pont* factor weighs heavily in plaintiff's favor in our likelihood of confusion analysis.

#### Similar Marks in Use on Similar Goods

The sixth *du Pont* factor requires us to consider evidence of "similar marks in use on similar goods." There is no such evidence of record in this case. Defendant has submitted printouts, from the USPTO's database, of various pending applications and issued registrations covering marks which defendant contends are similar to those at issue in this case. We find, however, that the vast majority of these printouts cover marks and goods which are dissimilar to the marks and goods at issue here. Even as to the handful of printouts which arguably cover marks and goods similar to those at issue here, such printouts are not evidence that the marks depicted therein are in use in commerce or that purchasers are aware of them. They are entitled to no probative value under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The sixth *du Pont* factor accordingly does not favor defendant in this case.

#### Actual Confusion (and the Opportunity for Actual Confusion)

The seventh *du Pont* factor requires us to consider evidence of "the nature and extent of any actual confusion." The eighth *du Pont* factor requires us to consider evidence pertaining to "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion."

\*11 The evidence of record in this case shows that neither plaintiff or defendant is aware of any instances of actual confusion between their respective marks in the marketplace. (Schwartz Depo. at 115-116; Sabatka Depo. at 57-59.) Although this fact weighs in defendant's favor under the seventh *du Pont* factor, it is immediately counterbalanced and negated by the eighth *du Pont* factor, because we cannot conclude on this record that there has been any substantial opportunity for any actual confusion to have occurred. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Although defendant's sales figures (which have been submitted under seal and shall not be detailed here) are not de minimis, neither are they so substantial as to warrant a presumption that the purchasers of plaintiff's goods necessarily have encountered defendant's goods in the marketplace (and that they thus have been in a position to be confused as to the source of the respective goods). Moreover, as defendant itself has noted, its gloves (as actually marketed) are not suitable for use in the operating room environment because they are non-sterile. This fact further diminishes the chances that both plaintiff's and defendant's actual goods have been encountered by the same actual purchasers in the marketplace.<sup>[FN13]</sup>

Because we cannot conclude (for purposes of the eighth *du Pont* factor) that there has been any significant opportunity for actual confusion to have occurred, we find that the absence of evidence of actual confusion (under the seventh *du Pont* factor) is neither factually surprising nor legally significant. See *Gillette Canada Inc. v. Ranir Corp. supra*. The seventh and eighth *du Pont* factors counterbalance each other, and they therefore are essentially neutral in this case.

### Conclusion regarding Likelihood of Confusion

Having considered the evidence of record as it pertains to the relevant *du Pont* factors, and for the reasons discussed above, we conclude that a likelihood of confusion exists. In particular, given the fame and strength of plaintiff's mark and name, the overall similarity of defendant's marks thereto, and the overlapping trade channels and classes of purchasers (including purchasers of varying levels of sophistication), we conclude that the parties' respective goods (as identified in the respective application and registrations) are sufficiently related that contemporaneous use of the parties' marks on such goods is likely to cause confusion as to source, sponsorship or other affiliation. To the extent that any doubt as to the correctness of this conclusion exists, it must be resolved in favor of plaintiff, the prior user, and against defendant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *Steelcase, Inc. v. Steelcare, Inc.*, 219 USPQ 433 (TTAB 1983); *Envirotech Corporation v. National Service Industries, Inc.*, 197 USPQ 292 (TTAB 1977).

### CONCLUSION

\*12 Based on the evidence of record, and for the reasons discussed above, we find that plaintiff has established its standing to bring these opposition and cancellation proceedings, as well as its pleaded Section 2(d) ground for opposition and cancellation.

**Decision:** Opposition No. 91123720 is sustained, and registration of the mark in the involved application Serial No. 75909304 is refused. Cancellation No. 92031730 is granted, and the involved Registration No. 2371569 shall be cancelled in due course.

FN1. The Board has ascertained that, subsequent to the completion of the briefing of these cases, opposer/petitioner's counsel, Ms. Zoubek, moved to a new firm, i.e., Jones Day. (She was with Pennie & Edmonds during litigation of these proceedings.) Although no written notification of the change of address was filed, to expedite matters the Board has updated its records for opposer/petitioner's correspondence address as follows: Nancy Zoubek, Jones Day, 222 East 41<sup>st</sup> St., New York NY 10017-6702. Applicant's counsel should do likewise.

FN2. Application Serial No. 75909304, filed February 3, 2000. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and January 5, 1998 is alleged in the application as the date of first use of the mark anywhere and the date of first use of the mark in commerce. Defendant has disclaimed the exclusive right to use PF apart from the mark as shown; the evidence shows that PF stands for "powder free." (Sabatka Depo. at 12, 26.)

FN3. Registration No. 2371569, which issued on July 25, 2000 from an application filed on May 20, 1998. In the registration, December 18, 1997 is alleged as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

FN4. In both cases, plaintiff also pleaded a claim of dilution under Trademark Act Section 43(c), 15 U.S.C. §1125(c). However, plaintiff presented no argument in support of a dilution claim in either its main brief or its reply brief, and we therefore deem plaintiff to have waived this pleaded ground in both cases. Additionally, in the "Statement of the Issues" sections of its main briefs in the opposition and cancellation proceedings, plaintiff states that an issue to be determined is whether defendant's marks falsely suggest a connection with plaintiff. Because no such Section 2(a) ground (15 U.S.C. §1052(a)) was pleaded or tried, and because plaintiff's briefs in-

clude no further argument as to such ground in any event, we have given this issue no consideration.

FN5. Issued December 10, 1974. Affidavits under Sections 8 and 15 accepted and acknowledged. Renewed for ten years from December 10, 1994.

FN6. Defendant also pleaded various "affirmative defenses." Two of them (i.e., that there is no likelihood of confusion, and that there is no dilution) are not properly deemed defenses but rather are mere further denials of plaintiff's pleaded claims. Defendant's "failure to state a claim" defense is without merit, inasmuch as plaintiff's pleadings in fact state claims for relief. Defendant's pleaded defenses of laches, estoppel, acquiescence and waiver are not supported by the evidence of record. Defendant's allegation that plaintiff is not the owner of its pleaded mark is likewise not borne out by the record.

FN7. We note, however, that this 1984 assignment document essentially is irrelevant to this case. As discussed *infra*, plaintiff has made of record a status and title copy (issued in 2002) of the pleaded registration which shows that the registration currently is extant and is owned by plaintiff, presumably by virtue of an assignment or assignments which occurred after 1984. The 1984 document showing a prior link in the chain of title is neither necessary to plaintiff's claim of current ownership of the registration, nor (contrary to defendant's contention) does it rebut that claim of ownership.

FN8. Defendant contends that plaintiff's evidence shows use of the mark on catalogs only, and fails to show affixation of the mark to the goods themselves. Defendant argues that plaintiff's use of the mark on its catalogs might establish service mark use but it does not establish trademark use. We are not persuaded. First, in the absence of any counterclaim for cancellation of plaintiff's pleaded registration, the affixation issue is irrelevant insofar as the goods identified in that registration are concerned. Second, plaintiff's catalogs include photographs of various items, including storage trays for the goods, upon which the mark has been affixed. Third, as plaintiff notes, the manner in which its mark is used in its catalogs constitutes valid technical trademark use, under *Lands End, Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992). Finally, even if we were to assume that the evidence does not establish technical trademark use by plaintiff, we find that it certainly is evidence of prior use analogous to trademark use and prior trade name use, both of which suffice to bar registration of defendant's marks under Section 2(d) (assuming that likelihood of confusion also is proven).

FN9. The Board may take judicial notice of dictionary definitions. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *see also* TBMP §704.12(a)(2d ed. rev. 2004).

FN10. We take judicial notice that "osteosynthesis" is defined as "internal fixation of a fracture by means of a mechanical device, such as a pin, screw, or plate." (*Stedman's Medical Dictionary* (27<sup>th</sup> ed. 2000) at 1286.) Plaintiff's witness Mr. Schwartz testified (on cross-examination) that the mark SYNTHES is derived from the name of a Swiss international foundation called AO/ASIF, with which plaintiff works closely in providing continuing medical education services, and that "AO stands for Arbeitsgemeinschaft fur Osteosynthesefragen." (Schwartz Depo. at 81, 89.) When asked what "Osteosynthesefragen" means, he testified as follows:

A. Fragen is - I believe a Swiss or German word for study. Excuse me, for issues or problems. So Synthesefragen is - osteosynthesefragen is bone healing issues.

Q. Is osteo bone?

A. Yes.

Q. And Synthes is healing?

A. Yes.

(Id. at 90-91. However, our own review of a German-English dictionary reveals that the German word "synthese" means "synthesis" in English, not "healing." (Cassell's German-English English-German Dictionary (1978) at 599.) Of course, in the context of osteosynthesis, the "healing" of a bone fracture could be described as a synthesis, i.e., a "combination of parts or elements so as to form a whole." Regardless of the derivation of plaintiff's mark or its meaning (if any) in German, we find that purchasers in this country are likely to perceive the mark, as applied to goods used in the field of osteosynthesis, as a truncation or derivative of the English word "synthesis."

FN11. Plaintiff has submitted copies of other registrations owned by defendant which cover a variety of other goods for medical and hospital use, including sterile gauze bandages, crutches, walkers, canes, stethoscopes and surgical gowns and bonnets. However, because these other goods of defendant's are not marketed under defendant's SYNTHESIS marks, they are not relevant to our likelihood of confusion analysis in these proceedings.

FN12. "Trauma products" are identified in the report as consisting of plates and screws, hip fixation devices, external fixation, intramedullary nails, staples, pins and wires, maxillofacial devices, and instruments.

FN13. This fact (i.e., the unsuitability of defendant's non-sterile gloves for use in the operating room environment) is legally irrelevant when we are comparing the parties' goods under the second *du Pont* factor, because our analysis under that factor must be based on the goods as identified in the application and registration, not on the goods as actually marketed by defendant. See discussion, *supra*. However, our analysis under the eighth *du Pont* factor requires us to consider the conditions under which the parties' goods actually have been marketed, i.e., the degree to which there has been any actual opportunity for confusion to have occurred.

2004 WL 1957205 (Trademark Tr. & App. Bd.)  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                               |   |                              |
|-------------------------------|---|------------------------------|
| INTUITIVE SURGICAL, INC.,     | ) |                              |
|                               | ) |                              |
| Opposer,                      | ) | Opposition No. 91175319      |
|                               | ) |                              |
| v.                            | ) | Serial No. 78/728,786        |
|                               | ) |                              |
| DAVINCI RADIOLOGY ASSOCIATES, | ) | Published: December 19, 2006 |
| P.L.,                         | ) |                              |
|                               | ) |                              |
| Applicant.                    | ) |                              |
|                               | ) |                              |

OPPOSER INTUITIVE SURGICAL, INC.'S RESPONSE  
TO APPLICANT'S EVIDENTIARY OBJECTIONS

On August 7, 2009, Opposer Intuitive Surgical, Inc. ("Opposer") filed its Main Trial Brief in Opposition Proceeding No. 9175319 ("Opposer's Brief"). As part of its Trial Brief, Applicant DaVinci Radiology Associates, P.L. ("Applicant") lodged objections to certain of the evidence referred to in Opposer's Brief. *See* Applicant DaVinci Radiology Associates, P.L.'s Trial Brief ("Applicant's Brief") at pp. 3-4. Pursuant to 37 C.F.R. § 2.128(b) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 801.03, Opposer hereby files its response to those evidentiary objections.

**I. EVIDENTIARY OBJECTIONS LODGED BY APPLICANT**

Applicant has objected to and requested the Trademark Trial and Appeal Board (the "Board") strike from the record the following evidence submitted by Opposer in this Proceeding:

[1] Exhibits 2 through 7 to Opposer Intuitive Surgical, Inc.'s First Notice of Reliance submitted in this Proceeding (referred to herein as ISNR1-2 through ISNR1-7); and

[2] The June 3, 2009 testimonial deposition of Benjamin Gong and Exhibit 27 thereto (referred to herein as IS-27).

Applicant DaVinci Radiology Associates, P.L.'s Trial Brief ("Applicant's Brief") at pp. 3-4.<sup>1</sup>

## **II. RELEVANT FACTS**

### **A. File Wrappers Submitted as Exhibits ISNR1-2 through ISNR1-7.**

Opposer submitted with Opposer Intuitive Surgical, Inc.'s First Notice of Reliance ("Opposer's First Notice of Reliance") the file wrappers or file histories of its applications for registration of the marks DA VINCI S, DA VINCI S HD SURGICAL SYSTEM, DA VINCI S HD SURGICAL SYSTEM (Stylized), DA VINCI SONICPRO, DA VINCI Si HD SURGICAL SYSTEM (Stylized) and DVSTAT DA VINCI SURGERY TECHNICAL ASSISTANCE TEAM (Stylized). These file histories were attached to Opposer's First Notice of Reliance and submitted as Exhibits 2 through 7 thereto, respectively, and are referred to herein as ISNR1-2 through ISNR1-7, respectively. *See* Opposer's First Notice of Reliance at ISNR1-2 through ISNR1-7. Applicant asserts in its Brief that these applications should be stricken from the record because they have "no relevance in the analysis of likelihood of confusion between Opposer's registration of DA VINCI and Applicant's application for" DAVINCI DIAGNOSTIC IMAGING & Design. Applicant's Brief at p. 4.

DA VINCI is registered in the name of Opposer for use with its computerized surgical systems. *See* Exhibit 1 (referred to herein as ISNR1-1) to Opposer's First Notice of Reliance; Exhibit 2 to Applicant's Notice of Reliance at item 37. Each of the file wrappers submitted as ISNR1-2 through ISNR1-7 are for marks that include the DA VINCI term, cover Opposer's

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<sup>1</sup> For clarity, Opposer addresses herein Applicant's objections in reverse order from the order in which those objections are presented in Applicant's Brief.

computerized surgical systems or related goods or services, are the subjects of applications pending before the U.S. Patent & Trademark Office and/or are in use by Opposer.

Specifically, ISNR1-2 is the file wrapper for the application for DA VINCI S in the name of Opposer, U.S. Trademark Application Serial No. 76/672,142 filed on February 2, 2007 and registered on January 13, 2009,<sup>2</sup> for use with its computerized surgical systems. *See* ISNR1-2; Exhibit 2 to Applicant's Notice of Reliance at item 28. Opposer's mark DA VINCI S has been in use in association with its surgical systems since at least as early as January 2006. January 28, 2009 Testimonial Deposition of Steve Annen ("Annen Tr.") at 24:6-13. ISNR1-3 is the file wrapper for the application for DA VINCI S HD SURGICAL SYSTEM in the name of Opposer, U.S. Trademark Application Serial No. 77/561,385 filed on September 3, 2008, for use with its computerized surgical systems. *See* ISNR1-3. Opposer's mark DA VINCI S HD SURGICAL SYSTEM has been in use in association with its surgical systems since at least as early as January 2007. Annen Tr. at 24:15-25:3. Similarly, Opposer's mark DA VINCI S HD SURGICAL SYSTEM (Stylized) is the subject of the application file wrapper submitted as ISNR1-4, U.S. Trademark Application Serial No. 76/665748 filed on September 8, 2008. The application for DA VINCI S HD SURGICAL SYSTEM (Stylized) is in the name of Opposer for use with its computerized surgical systems and has been in use by Opposer since at least as early as January 2007. ISNR1-4; Annen Tr. at 24:15-25:3. In addition, ISNR1-6 is the file wrapper for Opposer's application for registration of DA VINCI Si HD SURGICAL SYSTEM (Stylized), U.S. Trademark Application Serial No. 76/687,738 filed in the name of Opposer on March 14, 2008, for use with Opposer's computerized surgical systems. ISNR1-6.

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<sup>2</sup> At the time Opposer submitted its First Notice of Reliance, the application for registration of DA VINCI S was pending before the U.S. Patent & Trademark Office. However, since that time the DA VINCI S mark has registered, as evidenced by the copy of U.S. Trademark Registration No. 3,561,484 submitted by Applicant with its Notice of Reliance. Exhibit 2 to Applicant DaVinci Radiology Associates, P.L.'s Notice of Reliance at item 28.



ISNR1-5 is the file wrapper for the application for DA VINCI SONICPRO, U.S. Trademark Application Serial No. 77/292,138 filed in the name of Opposer on March 14, 2008, for use with ultrasonic cleaning equipment for computerized surgical systems. ISNR1-5. Opposer has continuously offered and sold goods under DA VINCI SONICPRO since at least November 2008. Annen Tr. at 18:12-19:13. Finally, ISNR1-7 is the file wrapper for the application for DVSTAT DA VINCI SURGERY TECHNICAL ASSISTANCE TEAM (Stylized), U.S. Trademark Application Serial No. 77/568,958 filed in the name of Opposer on September 12, 2008, for use with both Opposer's computerized surgical systems and technical support services for those systems. ISNR1-7.

**B. The Testimony Deposition of Benjamin Gong and Exhibit IS-27 thereto.**

Applicant submitted with Applicant DaVinci Radiology Associates, P.L.'s Notice of Reliance ("Applicant's Notice of Reliance") copies of a number of U.S. Trademark Registrations for marks that include the terms "DAVINCI" or "DA VINCI". See Exhibits 1 and 2 to Applicant's Notice of Reliance. One of the registrations submitted by Applicant is U.S. Trademark Registration No. 2,870,790 in the name of bioMerieux, B.V. ("bioMerieux") for the mark DA VINCI covering "discrete photometric analyzer for clinical use". Exhibit 2 to Applicant's Notice of Reliance, at item 27. Applicant admits that it submitted this registration to "show a crowded field of DA VINCI/DAVINCI marks used on similar goods and services". Applicant's Brief at p. 3. As part of its rebuttal case, Opposer sought to take the deposition upon written questions of Benjamin Gong. Applicant moved to strike Opposer's notice of that deposition, in part, on grounds the subject matter of the deposition would not be relevant to the subject matter of this Proceeding and would not rebut evidence submitted by Applicant. Applicant's Motion to Strike Opposer's Notice of Testimonial Deposition Upon Written Questions of Benjamin Gong, filed in this Proceeding, at pp. 1 & 3. The Board granted

Applicant's motion to strike the notice of testimonial deposition upon written questions and ordered the testimony be taken by oral examination instead. May 18, 2009 Order at p. 2. Pursuant to the Board's Order, the testimonial deposition of Mr. Gong was taken by oral examination on June 3, 2009. At his testimonial deposition, Mr. Gong authenticated a coexistence agreement between Opposer and bioMerieux and the co-existence agreement was entered into evidence as Exhibit 27 (IS-27) thereto. Testimonial Deposition of Benjamin Gong ("Gong Tr.") at 12:7-14:6 and IS-27. Applicant now asserts Mr. Gong's testimony is not relevant to the issues in this Proceeding and "rebutts nothing of Applicant's defense." Applicant's Brief at p. 4.

The subject matter of Mr. Gong's testimony was the basis upon which Opposer initiated the opposition proceeding against bioMerieux application for registration of D A VINCI, the basis upon which that opposition proceeding was resolved, and bioMerieux's use and registration of its DA VINCI mark. Mr. Gong, the Vice President of Finance of Opposer, testified that his job duties with Opposer in 2003 and 2004 included oversight of Opposer's legal activities relating to patents and trademarks. Gong Tr. at 10:18-20, 11:16-12:6. Mr. Gong further testified that Opposer initiated Opposition Proceeding No. 91158726 against bioMerieux's application for registration of DA VINCI, in part, to engage bioMerieux and ultimately limit its use of the DA VINCI mark in the United States. *Id.* at 14:14-15:23. Specifically, Opposer felt the photometric analyzers and immunoanalyzers identified in bioMerieux's application differed from goods offered under Opposer's mark DA VINCI but wished nonetheless to prevent bioMerieux from expanding its use and registration. As part of the parties' resolution of Opposition Proceeding No. 91158726, Opposer sought and obtained from bioMerieux, bioMerieux's agreement that it would not use or register DA VINCI for goods other than photometric analyzers and

immunoanalyzers. Gong Tr. at 17:12-19:14; IS-27 at p.1 (Recitals Paragraph 1) & p. 2 ("bioMerieux agrees" Paragraph 1).

### III. ARGUMENT

#### A. File Wrappers Submitted as Exhibits ISNR1-2 through ISNR1-7.

A party may have protectable rights in both registered and unregistered marks. *Russell v. Caeser*, 62 U.S.P.Q. 1125, 1127 (N.D. Cal. 2001); *Glow Industr., Inc. v. Lopez*, 252 F. Supp.2d, 962, 976-77 (C.D. Cal. 2002). Further, opposition to registration of a trademark may be based upon the opposer's common law rights (via use) in an unregistered mark as well as its rights in a registered mark. 15 U.S.C. § 1052(d). The issue in this opposition proceeding is the likelihood of confusion between Opposer's DA VINCI marks and Applicant's mark DAVINCI DIAGNOSTIC IMAGING & Design. See Opposer's Brief at pp. 5-6; Applicant's Brief at pp. 4-5. Part of the likelihood of confusion analysis is consideration of the similarity of the parties' marks and the similarity of the parties' respective goods and services. *In re E.I. DuPont deNemours & Co.*, 177 U.S.P.Q.2d 563, 567 (CCPA 1973). Evidence is relevant when it has "any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." Federal Rule of Evidence ("FRE") 401. Further, generally all relevant evidence is admissible. FRE 402. The file wrappers of Opposer's applications for other DA VINCI marks are relevant here.

Together with the testimony of Steve Annen submitted in this Proceeding regarding Opposer's use of its DA VINCI marks, the application file wrappers submitted as ISNR1-2 through ISNR1-7 demonstrate that: (1) Opposer owns a number of marks in which DA VINCI is the dominant term; (2) each of Opposer's DA VINCI marks is the subject of a pending application and/or is in use with Opposer's surgical systems, other goods in the medical/field

(i.e., ultrasonic cleaning equipment for computerized surgical systems), or services in the medical/surgical field (i.e., technical support for computerized surgical systems); and (3) Opposer has protectable rights in its DA VINCI marks. The multitude of Opposer's DA VINCI marks, applications seeking registration of those marks and continuous use of the marks in commerce demonstrate Opposer's rights in the marks and the DA VINCI term that is dominant in each of the marks. Accordingly, Opposer's opposition to the application for registration of DAVINCI DIAGNOSTIC IMAGING & Design may be based on Opposer's marks DA VINCI S HD SURGICAL SYSTEM, DA VINCI S HD SURGICAL SYSTEM (Stylized), DA VINCI Si HD SURGICAL SYSTEM (Stylized), DA VINCI SONICPRO and DVSTAT DA VINCI SURGERY TECHNICAL ASSISTANCE TEAM (Stylized), as well as Opposer's registered marks DA VINCI and DA VINCI S.

Opposer's rights in its DA VINCI marks, including its rights in the DA VINCI term common to both parties' marks, and the nature of the medical/surgical goods and services offered under Opposer's marks also are relevant to the comparison of marks and goods/services that is part of the likelihood of confusion analysis in this proceeding in that the use of multiple DA VINCI marks by Opposer in the medical/surgical field, a niche Applicant also is seeking to occupy with its DAVINCI DIAGNOSTIC IMAGING & Design mark, makes likelihood of confusion between the parties' respective marks more probable. According the file wrappers submitted as ISNR1-2 through ISNR1-7 are relevant to the issues in this Proceeding and should be considered by the Board.

**B. The Testimony Deposition of Benjamin Gong and Exhibit IS-27 thereto.**

Contrary to Applicant's assertion, the testimony of Benjamin Gong and IS-27 thereto are relevant to issues in this case and, in fact, directly rebut evidence offered by Applicant in this Proceeding. Evidence is relevant when it has "any tendency to make the existence of any fact

that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." FRE 401. Relevant evidence is generally admissible. FRE 402. To demonstrate "a crowded field", Applicant submitted in this Proceeding a copy of Registration No. 2,870,790 in the name of bioMerieux for the mark DA VINCI for use with discrete photometric analyzers.<sup>3</sup> Applicant's Brief at p. 3. Applicant appears to request that the Board consider third party registrations alone for the purpose of determining the strength of Opposer's mark and whether a crowded field exists in this case. In fact, Opposer expressly points to bioMerieux's registration of DA VINCI as a registration that causes a crowded field. Applicant's Brief at p. 29. As described more fully in Opposer's Brief, the evidence of third party registrations submitted here is not probative of the strength of Opposer's marks or of whether or not Opposer's marks inhabit a crowded field, and the Board should not consider such evidence for that purpose. Opposer's Brief at pp. 45-47; *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). Nonetheless, as Applicant is pointing to bioMerieux's registration as a registration that demonstrates a crowded field, Opposer should be permitted to submit evidence that factually rebuts Applicant's assertion should the Board consider the third party registrations made of record.

As indicated by the regulation made of record by Applicant, discrete photometric analyzers are laboratory instruments. Exhibit 7 to Applicant's Notice of Reliance. Mr. Gong's testimony that Opposer considers these laboratory instruments to be different from goods offered by Opposer under its marks supports that Opposer's surgical systems and bioMerieux's discrete photometric analyzers are unrelated goods. Mr. Gong further testified that the opposition

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<sup>3</sup> Applicant has made only third party registrations of record in this Proceeding. No evidence of third party use has been made of record. See Applicant's Notice of Reliance.

proceeding against bioMerieux's then-application was initiated by Opposer, in part, to prevent bioMerieux from expanding its use of DA VINCI to any goods that lie within Opposer's medical/surgical niche and to thereby prevent bioMerieux from using the mark on any goods related to those of Opposer. As a result of the opposition proceeding and as part of its resolution, bioMerieux agreed not to use or register DA VINCI for any goods or services other than discrete photometric analyzers, thereby protecting Opposer's rights in its DA VINCI marks. The co-existence agreement between bioMerieux and Opposer, setting forth the terms of the parties' agreement is attached to Mr. Gong's testimonial deposition as Exhibit 27 (IS-27). Mr. Gong's testimony and IS-27 make it more probable that the goods covered by bioMerieux's registration are unrelated to Opposer's goods and that bioMerieux will not expand its use of DA VINCI to any goods or services related to Opposer's goods or within Opposer's medical/surgical niche. Further, Mr. Gong's testimony and IS-27 demonstrate that Opposer takes action to protect its rights in its DA VINCI marks. Accordingly, Mr. Gong's testimony and IS-27 are relevant to Applicant's assertion that bioMerieux's registration serves to weaken Opposer's marks and directly rebuts evidence submitted by Opposer. Mr. Gong's testimony and IS-27 should not be stricken from the record and, instead, should be considered by the Board.

#### **IV. CONCLUSION**

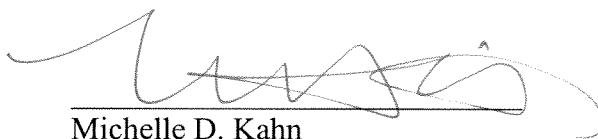
Based on the foregoing, Opposer requests the Board: (1) deny Applicant's request that ISNR1-2 through ISNR1-7 be stricken from the record; (2) deny Applicant's request that the testimonial deposition of Benjamin Gong, and IS-27 thereto, be stricken from the record; and (3)

consider ISNR1-2 through ISNR1-7 and the testimony of Benjamin Gong and IS-27 thereto for purposes of rendering its decision in this Proceeding.

Dated: September 22, 2009

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By

A handwritten signature in black ink, appearing to read "Michelle D. Kahn", written over a horizontal line.

Michelle D. Kahn

Michelle J. Hirth

Attorneys for Opposer

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**CERTIFICATE OF SERVICE**

*Intuitive Surgical Inc. v. DaVinci Radiology Associates, P.L.*  
Opposition No. 91175319

On September 22, 2009 I hereby certify that I served a copy of the following:

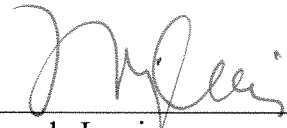
1. Opposer Intuitive Surgical, Inc.'s Reply Trial Brief;
2. Appendix of Authorities in Support of Opposer Intuitive Surgical, Inc.'s Reply Trial Brief; and
3. Opposer Intuitive Surgical, Inc.'s Response to Applicant's Evidentiary Objections

by U.S. Mail to:

Matthew T. Vanden Bosch, Esq.  
301 Clematis Avenue, Suite 3000  
West Palm Beach, FL 33401

Attorneys for Applicant

Executed on September 22, 2009, at San Francisco, California.

  
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Mironda Lewis